

No. 12,485

IN THE

United States Court of Appeals
FOR THE NINTH CIRCUIT

LEROY J. LEISHMAN,

Defendant-Appellant,

v.s.

GENERAL MOTORS CORPORATION,

Plaintiff-Appellee.

APPELLANT'S REBUTTAL BRIEF.

LEROY J. LEISHMAN,

In Propria Persona.

FILED

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I.

Introduction.

Appellee's Reply Brief is primarily a strong attempt to create the false impression that there has been practically a unanimity of opinion against the present defendant on all issues among the courts that have considered the patent here at issue, and appellee would have this Honorable Court feel that the weight of opinion against validity and infringement is so heavy that little attention need be paid to the evidence now before it. Actually, there has been such a wide divergence in the previous opinions that this Honorable Court is clearly called upon to thoroughly reappraise the findings in the light of the evidence and to base its decision solely upon the facts.

Another thing that should alert this Honorable Court to far more than the usual vigilance in the instant case

is the opinion of the U. S. District Court for the District of New Jersey in *United States v. General Instrument Corporation, Radio Condenser Company et al.*, 87 Fed. Supp. 157. These violators of the Sherman Act were the plaintiffs-appellees in the last appeal that reached this Honorable Court respecting this patent, the suit having been filed as a part of their illegal activities. They sought to monopolize the manufacture of variable condensers and coaxial rocker-and-tappet tuners for resale to manufacturers of radio sets. Leishman tried unsuccessfully by means of interrogatories in the lower court here to bring out some of the irregular conduct of these litigants, and he would have pursued the matter further at a trial had not the opportunity been denied him by the hasty termination of the proceedings by summary judgment. One of the exhibits in the government's case against these conspirators was a letter from Maxwell James whose name appeared on their appeal brief before this Honorable Court. In that letter¹ Mr. James said that Condenser Development Company, the *alter ego* for Radio Condenser and General Instrument, had aided the attorneys in the *Associated* case in this circuit. Appellee's Exhibit No. 1 in the instant case [R. 695] is another letter from Maxwell James, written on behalf of General Instrument Corporation. These companies found guilty in the government's case have thus had a finger in all the litigation regarding this patent in this circuit. In his letter in the present record, Mr. James says that a weight and a spring are equivalents for rais-

¹It is believed that this Honorable Court may wish to take judicial notice of this letter, and a copy, certified by the clerk of the U. S. District Court for the District of New Jersey, is therefore being filed herewith as Defendant's Exhibit AAAA. The pertinent part appears in the Appendix at the back of this brief, pp. 3 and 4.

ing tappets *up*, but he won the aforementioned summary judgment against Leishman on the irreconcilable ground that plungers and levers are *not* equivalents for pushing them *down*.

On page 5 of its brief, appellee correctly says: "In spite of the complicated litigious history of the patent in suit, the issue on this appeal is not complicated." *None* of the issues have been complicated. One naturally wonders, then, why the litigious history has been complicated. Examination of the opinions soon reveals that the complications regarding the issue of validity have arisen because two courts blindly followed previous decisions instead of the evidence before them. Appellee now wants this Honorable Court to do the same. Brief references to the previous opinions will show wherein the complications have arisen, and should make it apparent that the present appeal can only be decided by returning to the facts and making a completely new adjudication.

The first decision of invalidity was that of Judge Harrison, rendered on a very incomplete record in the *Associated* case. He held the claims here at issue invalid for want of invention. On appeal, counsel for the present plaintiff tried very hard to support Judge Harrison's opinion, but were unable to convince this Honorable Court that the holding of invalidity for want of invention should be affirmed. The rule then, as now, was that the findings of a lower court are not to be disturbed unless clearly in error. This Honorable Court disturbed Judge Harrison's findings, saying:

" * * * The judgment declares that the claims 'are invalid for want of invention.' In the view we take, the declaration is unnecessary. As to its correctness or incorrectness, we express no opinion.

"The judgment is modified by striking therefrom the above quoted declaration and, as thus modified, is affirmed." (137 F. 2d 722, 727, 728.)

The presumption of validity was thus restored to the patent, and the holding of invalidity was wiped out.

The next decision was that of the District Court for the Western District of Oklahoma in *Leishman v. The Richards and Conover Company*, Civil Action No. 2155, involving tuners patentwise the same as those now before this Honorable Appellate Court. Judge Chandler there held the claims "clearly valid and clearly infringed." This decision, following that in which this Honorable Court wiped out Judge Harrison's holding that the claims were invalid for want of invention, strongly reinforced the presumption of validity.

When the *Richards and Conover* case was appealed, the Court of Appeals for the Tenth Circuit manifestly overlooked most of the evidence and testimony, and based the first of its two decisions upon an uncritical reading of Judge Harrison's opinion in the *Associated* case. The Court of Appeals for the Tenth Circuit even paraphrased the same obvious errors. Judge Harrison, in explaining why he thought the provision of a coaxial relationship between the tappet and rocker did not amount to invention, said (36 Fed. Supp. 804, 808) :

"The importance of the mechanical relationship is well known in the art and a feature that must be considered in all machine designing when you desire parts to move together harmoniously and free from friction. . . . It is a mechanical principle that is hundreds of years old." (Emphasis added.)

Entirely overlooking that the purpose of the coaxial relationship in Leishman's structure was just the opposite from this, and that its purpose was to *prevent* absolutely *all* rotation of the rocker during the adjusting process, the Court of Appeals paraphrased Judge Harrison's clearly erroneous statement and held (172 F. 2d 365, 369):

“The principle of coaxial relationship and its importance, where it is desired that two parts of a machine *operate together harmoniously*, has been within the knowledge, for many years, of ordinary mechanics skilled in their art.” (Emphasis added.)

In Leishman's Petition for a Rehearing, he pointed out the clear error of the Court, saying:

“In correctly explaining that coaxiality of the tappet and rocker is for the purpose of *preventing movement*, and then ruling that no invention is involved because the coaxial relationship has been known for many years ‘where it is desired that two parts of a machine *operate together harmoniously*’, the written opinion of this Honorable Court has failed to distinguish between two things that are diametrically opposite.

“The Court has properly held that:

‘The principle of coaxial relationship and its importance where it is desired that two parts of a machine operate together harmoniously, has been within the knowledge, for many years, of ordinary mechanics skilled in the art.’

But the corollary of this is that appellee's use of coaxiality for the *prevention of rotation* of the tappet and rocker, was in direct conflict with the teachings of the prior art and therefore beyond the knowledge

of ordinary mechanics. Appellee's contribution accordingly would rise to the dignity of invention if judged by the formula given in the opinion.

"It thus appears that the Court's ruling of invalidity may have been inadvertent or that the paradox of the two conflicting propositions appearing in the opinion was not apparent to the Court because of the absence of four physical exhibits which had been designated as part of the record on appeal, or because the Court may have failed to consider certain testimony of defendant's expert witness that was of course binding upon the defendant."

The requested rehearing was granted, but the court, instead of admitting and correcting its error, said not a word about the error in its new opinion but sought to justify its first decision by making a purported mathematical analysis of the reasons for creeping. The greater errors into which the Court then fell have been thoroughly demonstrated in Appellant's Opening Brief and in the affidavits of the Professor of Mechanical Engineering of California Institute of Technology, the Professor of Mechanical Engineering at the University of Southern California, as well as those of other reputable authorities. Without reiterating these errors here, suffice it to say that there would have been no need for the Court of Appeals for the Tenth Circuit to render a second opinion if it had followed the evidence instead of adopting Judge Harrison's opinion without comparing it with the facts.

Although it was the manifest duty of the court below to decide the present case on the evidence before it, and to resort to comity only in the event that it was in doubt after thoroughly weighing all the facts, the Court never-

theless stated during the first hours of the trial that it wasn't going to decide this case until it found out what the Court of Appeals for the Tenth Circuit was going to do. The following appears in the record of the first day's proceedings:

"The Court: Was the case in Oklahoma appealed?

The Witness: Yes, it was appealed and the record has been printed and the appellant has already filed its brief and we were due to file ours next week in printed form but due to this case we have asked for an extension of 30 days to give us time to prepare it.

The Court: You had better file it. I don't think you need to worry about this case until it is filed there. *I would like to see what the Circuit Court of Appeals there says about it.*

Mr. Flam: That is quite impossible for us to do unless you continue this trial.

The Court: I am not going to continue it now. I think it might have been continued but it wasn't. However, I am not going to decide this case until you have sufficient time to prosecute your appeal or the other side does.

Mr. Flam: I think Judge Yankwich was very adverse to any continuance.

The Court: He was but he isn't trying the case now. I am controlling the case now.

The Court: Now, I am not going to continue it at all but *I am not going to decide it either until you have an opportunity to have the Tenth Circuit Court of Appeals pass on it.*

You have a decision from the Ninth Circuit—you have two decisions from the Ninth Circuit and *I want to know what the Tenth Circuit says about it.*" [R. 185-186.] (Emphasis added.)

This intention to lean on the decision of the Court of Appeals for the Tenth Circuit was voiced by the Court below before it had any idea of the nature of the evidence that would be presented.² The subsequent statement in the lower court's decision that it was greatly influenced by the opinion of the Court of Appeals for the Tenth Circuit is thus not surprising. The allusions to the present record extend only from the bottom of page 46 to the middle of page 48, Vol. I.

These last two decisions of invalidity thus came about by placing reliance on previous opinions, instead of carefully examining the evidence. Appellee's brief is a strong plea to get this Court to do the same.

²Such a procedure is in marked contrast to the recommendations of the Supreme Court in *Mast, Foos & Company v. Stover Manufacturing Company*, 177 U. S. 485, 488; 20 S. Ct. 708, 710; 44 L. Ed. 856, 858, where the court said:

"Comity persuades; but it does not command. . . . It recognizes the fact that the primary duty of every court is to dispose of cases according to the law and the facts; in a word, to decide them right. In doing so, the judge is bound to determine them according to his own convictions. If he be clear in those convictions, he shall follow them. It is only in cases where, in his own mind, there may be a doubt as to the soundness of his views that comity comes in play and suggests a uniformity of ruling to avoid confusion, until a higher court has settled the law. It demands of no one that he shall abdicate his individual judgment, . . ." (Emphasis added.)

II.

The Findings of the Lower Court Do Not Have the Finality That Appellee Alleges.

- (a) Even Where the Findings Have Some Support, Which Is Not True Here, the Appellate Court Is Not Bound by Them if Other Facts Show the Conclusions to Be in Error.

Appellee's argument begins with the assertion that a finding of fact, such as a finding of lack of invention in this case, must not be disturbed.

Such a finding, based upon physical evidence and documentary evidence, does not have the weight attributed to it by appellee. Especially is this the case where the trier of facts is the Court and not a jury.

One of the clearest expressions of this matter is found in the recent Supreme Court case of *United States v. United States Gypsum Co.*, 333 U. S. 364, and particularly page 395. The Court uses the following explicit language:

“* * * Since judicial review of findings of trial courts does not have the statutory or constitutional limitations of findings by administrative agencies or by a jury, this Court may reverse findings of fact by a trial court where ‘clearly erroneous.’ The practice in equity prior to the present Rules of Civil Procedure was that the findings of the trial court, when dependent upon oral testimony where the candor and credibility of the witnesses would best be judged, had great weight with the appellate court. The findings were never conclusive, however. A finding is ‘clearly erroneous’ when although there is evidence to support

it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed."

This statement by the Supreme Court regarding the effect of findings is authoritative reiteration of the doctrine expressed in decisions of appellate courts throughout the country. Thus in *Kuhn v. Princess Lida of Thurn & Taxis*, 119 F. 2d 704, decided by the Court of Appeals for the Third Circuit, the following statement appears at page 706:

"The sufficiency of the evidence to sustain a trial court's conclusion or finding of an ultimate fact remains appropriate matter for an appellate court's consideration. State Farm Mutual Automobile Insurance Co. v. Bonacci *et al.*, 8 Cir., 111 F. 2d 412, 415. Where the evidentiary facts are not in conflict or dispute, the conclusions to be drawn therefrom are for the appellate court upon review of the trial court's action. Cf. United States v. South Georgia Railway Co., 5 Cir., 107 F. 2d 3, and United States v. Mitchell, 8 Cir., 104 F. 2d 343, 346. An incorrect conclusion by a trial court qualifies as a 'clearly erroneous' finding, for the correction whereof on appeal Rule 52(a) specifically provides."

In fact, in our own circuit the Supreme Court's decision hereinabove referred to was applied. In *Pacific Portland Cement Co. v. Food Machinery & Chemical Corporation*, 178 F. 2d 541, this Honorable Court at page 548 says:

"* * * Full effect will always be given to the opportunity which the trial judge has, *denied to us*,

to observe the witnesses, judge their credibility, and draw inferences from contradictions in the testimony of even the same witness. *Savage v. Lorraine*, 9 Cir., 1945, 148 F. 2d 818; *Augustine v. Bowles*, 9 Cir. 1945, 149 F. 2d 93, 96; *Lincoln National Life Ins. Co. v. Mathisen*, 9 Cir., 1945, 150 F. 2d 292, 295-296. This is the meaning of the provision that findings should not be set aside unless clearly erroneous. *Grace Bros. v. Commissioner*, 9 Cir., 1949, 173 F. 2d 170, 173-174. In contrast, the Supreme Court has told us that, 'A finding is "clearly erroneous" when although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed.' *United States v. United States Gypsum Co.*, 1948, 333 U. S. 364, 395, 68 S. Ct. 525, 542, 92 L. Ed. 746."

In a still later case, *Orvis v. Higgins*, 180 F. 2d 537, the Court of Appeals for the Second Circuit states as follows on page 539:

"Where a trial judge sits without a jury, the rule varies with the character of the evidence: (a) If he decides a fact issue on written evidence alone, we are as able as he to determine credibility, and so we may disregard his finding. (b) Where the evidence is partly oral and the balance is written or deals with undisputed facts, then *we may ignore the trial judge's finding and substitute our own*, (1) if the written evidence or some undisputed fact renders the credibility of the oral testimony extremely doubtful, or (2) if the trial judge's finding must rest exclusively on the

written evidence or the undisputed facts, so that his evaluation of credibility has no significance." (Emphasis added.)

In the present instance the basic facts regarding the question of invention are undisputed. The documentary evidence, including the patents of Cunningham, Marschalk and Schaefer, is of course undisputed, nor is there a scintilla of evidence in conflict regarding the interpretation and meaning of these important documents.

Accordingly, the rule as expressed in the Supreme Court case and in *Pacific v. Food Machinery* applies. This Honorable Court may reappraise the evidence independently of the findings.

(b) There Is No Evidence Whatever to Support the Lower Court's Findings With Respect to the Issue of Invention.

On page 28 of its brief, appellee says:

"Judge McCormick below found as a fact that the patent in suit lacked invention [Finding of Fact No. 15, R. 54]. Appellee has shown hereinbefore that under fundamental principles of appellate review, a mere existence of evidence from which invention might be inferred is not competent to upset an express finding of fact of non-invention where substantial evidence supports such finding."

Appellee here apparently admits the existence of evidence of invention, but nevertheless insists that there is substantial evidence to support the finding of non-invention. Re-

garding the latter point, appellee's brief says on pages 13 and 14:

“* * * To induce this Court to overturn Judge McCormick's findings of fact, appellant must demonstrate that there exists no evidence in the record which might have led Judge McCormick to his conclusion that the patent is anticipated and lacks invention. This, appellee submits, appellant has not even purported to do.”

Appellant not only purported to do what appellee says he did not purport to do, but he demonstrated in the opening brief that there exists no evidence whatever to support Judge McCormick's conclusion that the patent is anticipated and lacks invention. The lower Court's only references to the record before it had to do with the Marschalk, Schaefer and Cunningham patents. Appellant's opening brief showed that the lower Court was entirely in error in holding that appellant's structure was anticipated by Marschalk and Schaefer, and it was also demonstrated that the Cunningham device was from a remote and non-analogous art and that it had to be substantially altered in both structure and mode of operation in order to be given a semblance of pertinence. Appellee has discussed these references in an attempt to make it appear that there is something about them that might be interpreted as supporting Judge McCormick's findings. What appellee has said in this respect will be hereinafter treated in connection with each of the arguments which appellee has raised with regard to these specific patents.

III.

The Problem Effectively Solved by Appellant Did Not Originate With Marschalk as Appellee Contends, but Confronted Every Inventor Who Undertook to Provide an Adjustable Tappet Tuner.

Appellee's statements that the problems solved by appellant was posed by Marschalk (App. Br. p. 30) and "could not have been present prior to 1937" (p. 34) are inconsistent with appellee's own argument in support of the lower Court's erroneous finding that *appellant's solution to the creeping problem is anticipated in the light of the teachings of Marschalk and Schaefer*. If the creeping problem was first posed by Marschalk, how can appellee urge that Schaefer, who preceded Marschalk by four years, had a solution for creeping? Appellee's thesis refutes itself. If the problem originates with and is posed by, the device shown in the Marschalk patent, as appellee now contends, how can appellee also argue that Marschalk himself teaches the solution to the problem? Actually, the creeping problem confronted *everyone* who undertook to provide an adjustable tappet tuner *regardless of whether he worked before or after Marschalk*, but the peculiar behavior of his device, which he did nothing about, demonstrates the problem that confronted every worker in the art. The laws of nature did not suddenly change and pose a problem for Marschalk only. Neither Schaefer nor Leishman had ever heard of Marschalk when they encountered the problem; but since Marschalk had no solution of any kind, his device demonstrates in an effective manner the peculiar dif-

ficulty that faced everyone who undertook to provide an adjustable tappet tuner. Schaefer, who preceded Marschalk, had a solution for the creeping difficulty, but it was vastly different from Leishman's and required eighteen more parts.

In an effort to confuse the court, appellee attempts to reverse history regarding when rockers were introduced, appellee's brief (p. 18) saying: "When Marschalk substituted for the rack and pinion of Schaefer the rocker of Marschalk, the deletion [of parts] of which appellant speaks was compelled, a rocker inherently including less parts than a rack and pinion system." Actually, long before Schaefer, the customary procedure was to employ rockers engaged by tappets, and the rack and pinion system did not appear until Schaefer introduced it to eliminate the difficulties that confronted everyone who undertook to make the tappet adjustable.

Kettel and Woodbridge, discussed in appellant's Opening Brief on pages 14 to 17, both used rockers that were directly engaged by tappets, as shown in the pertinent figures from their patents reproduced on the folding insert at the back of the appendix to appellant's Opening Brief. Judge Harrison correctly asserted, after describing the Woodbridge device, that "the problem before any person desiring to adapt a rocker and tappet to a radio tuning device was to develop a means for an accurate and simple method of adjusting the tappet so that it would, when in complete engagement with the rocker, rotate it to the angle

required to bring in the particular station that the user might designate." (36 Fed. Supp. 804, at 808.)³

In the *Radio Condenser* case as well as in the present case the Kettel and Woodbridge patents, both of which employ rockers engaged by tappets, are respectively the first and third patents on the pertinent prior art cited right in the complaint, and appellee's counsel is thus hardly in a position to assert now that Marschalk introduced the rocker and was responsible for eliminating the rocker and pinion system. Schaefer *departed* from the prior art by separating his tappet from the rotatable member and interposing the rocker and pinion system that eliminated creeping in his device, and the Schaefer-Zenith tuner and the Schwarz-General Motors tuner are the only ones in the art that have employed it.

In attempting to support Judge McCormick's finding that the Marschalk device was an anticipation of appell-

³The idea of the pertinence of the Woodbridge device in which the rocker was engaged by fixed tappets, did not originate with Judge Harrison but rather with the present appellee's counsel and expert, Mr. Leonard S. Lyon, Sr., and Dr. Mackeown, who opposed the patent in the *Associated* case. In the *Associated* case the Woodbridge patent was not cited in the original answer to Leishman's complaint (p. 7 of the *Associated* record, Appeal No. 9970) but was included in an amendment to the answer [R. 12 of the *Associated* record] that was filed by Lyon and Lyon. The present counsel at that time recognized that it was pertinent prior art, and it was considered of such importance to the case that it was discussed by Dr. Mackeown in the portions of his testimony in that case extending from pages 418 to 420, and it was again referred to on page 443.

In recognizing that rockers engaged by tappets were old in the prior art, as shown by Woodbridge, and that the problem before the radio industry was to develop "an accurate and simple method of adjusting the tappet," Judge Harrison thus merely adopted the thesis that counsel now denies by stating that "the problem could not have been present prior to 1937."

lant's structure, appellee erroneously makes the statement regarding Marschalk's device on page 15 that "the mechanism for rotating the condenser shaft and thus tuning the receiver, however, is the same as that of the re-issue patent in suit." This, of course, is manifestly incorrect, because the Marschalk device does not employ appellant's method or structure for eliminating creeping; in fact, it employs nothing whatever to eliminate this difficulty, but exhibits it in marked degree.

After incorrectly stating that the Marschalk and Leishman devices are the same, appellee's brief then says (p. 18) that "the Marschalk patent, which followed the Schaefer patent and Zenith tuner, did not include this coaxiality is easily understood in view of the fact that in the Marschalk patent the levers of the tuner were intended to be automatically operated by electric control means including solenoids for control by timing devices, whereas the Schaefer patent and Zenith tuner were for hand-operated radio sets," Why this should have made the inclusion of the coaxial relationship less desirable, appellee does not say. Actually, the fact that the Marschalk device was electrically operated greatly *increased* the desirability of employing an effective way to eliminate creeping. In an attempt to minimize the setting difficulty in the Marschalk structure appellee's brief (p. 19) quoted Judge Harrison's trial comment as follows:

"The court has tried the instrument and the witness' testimony does not add anything to what the court has already ascertained from an examination

and an effort on its part to work the mechanical device. I had no difficulty in setting the device at the extreme end, *but it is true that a person has to use a greater amount of care.* That was the result of the court's own experiment with the instrument."

(Emphasis added.)

Even with the advantage of having the mechanism in the open before him, stripped of the cabinet and other parts that would complicate the problem and make it difficult to see what he was doing, Judge Harrison nevertheless had to use "a greater amount of care" than when setting a tuner containing the coaxial relationship that the industry has now adopted on such a large scale because "this system is so simple and foolproof," to use the words of the Zenith Corporation [Deft. Ex. FFF, R. 1140]. When the Marschalk mechanism is in its cabinet and connected to the solenoids, the difficulties are magnified. The solenoids pull the tappet down with a bang; and since it is thus not manually operated, there is no opportunity to use any care whatever. It consequently becomes almost impossible to set the device.

Appellee's reasons why Marschalk did not employ a coaxial relationship between his tappet and rocker are thus manifestly whole cloth. Marschalk did not employ this method of eliminating creeping for the same reason that it was not employed by Schaefer and Schwarz and Soffietti and Lane and Mackey—it did not occur to them and was beyond their mechanical skill and rose to a level of invention that they did not possess.

IV.

The Axis of Schaefer's Tappet Is Widely Spaced From the Axis of His Rotatable Member, and Appellee's Attempt to Import Some Other Axis Into Schaefer's Device Is Pure Sophistry. There Is Nothing in the Record to Dispute the Testimony That Schaefer Avoided Creeping by the Interposition of Extra Parts Between His Tappet and Rotatable Member.

Appellee contends, in the subheading on page 16 and in the argument on pages 17 to 20, that the Schaefer device embodies the coaxial relationship and anticipates appellant's use thereof; and appellee's argument is largely an attempt to import an extra axis into Schaefer's structure and to make it appear that this non-existent axis is coaxial with that of the tappet. This argument is pure sophistry.

The drawings of the reissue patent here at issue disclose the coaxial relationship between the rotational axis of the tappet and the rotational axis of the rocker; the specification describes the coaxial relationship between the rotational axis of the tappet and the rotational axis of the rocker; and the claims that mention the coaxial relationship specifically mention that the axis of the tappet is coaxial with the axis of the rocker when these members are in complete engagement. It is obvious upon even a cursory inspection of Schaefer's device or his patent, or the drawing of the pertinent parts thereof on page 27 of Appellant's Opening Brief, that there is no such relationship in the Schaefer structure, and that the axis of his tappet 56, instead of being coaxial with the axis of his rotatable member 9, is actually widely spaced therefrom.

The axis in appellant's combination that is coaxial with that of the tappet is clearly a rotational axis. Moreover, it is an axis of rotation around which the rotatable member rotates. The corresponding axis in Schaefer is the axis of his rotatable positionable member 9, and there is no rotational axis that is coaxial or coincident with the axis of the tappet.

If the lower court's findings about Schaefer were supported by evidence, such evidence would necessarily have to show a second rotational axis coaxial with the axis of the tappet. As there is no such axis and no such evidence, appellee attempts to create one by sophistry. In effect, appellee's argument is substantially this: If we assume an axis in the Schaefer mechanism that is coaxial with the axis of the tappet, the axis of the tappet and the assumed axis will be coaxial. A coaxial relationship can be imported into absolutely any device by that type of argument.

Appellee's brief says (p. 17): "It will be noted that in the Schaefer device the arms numbered 32 and 34 of the rack and pinion move symmetrically about a line or axis. This axis or symmetrical point is located midway between the arms 32 and 34, and horizontally at a point aligned with the arms 32 and 34 when the said arms are moved to a common level." There obviously is no such axis in Schaefer's device, and whether or not there is a symmetrical point midway between the arms 32 and 34 is entirely immaterial. There is a symmetrical point between a person's eyes and between a person's ears, but this can hardly be called an axis. Such a symmetrical

point is far removed from what we are talking about in this case.

Appellee hypothecates "this axis or symmetrical point . . . horizontally at a point aligned with the arms 32 and 34 when the said arms are moved to a common level." Appellee does not say *what part* of the arms 32 and 34 this point is aligned with. The specification and claims of the patent here at issue require that the axis of the tappet be aligned with the rotational axis of the rocker. Since Schaefer's arms 32 and 34 have no rotational axis, appellee of course was at a loss to state just what portion of the arms 32 and 34 is referred to in this statement that the point is horizontally aligned with these arms. If a rocker instead of the arm and rack system were employed in Schaefer's mechanism it would make a great deal of difference where the rotational axis of the rocker would be located, because the rocker and tappet must obviously be so designed with respect to each other that the two rotational axes will be coincident. If the axis of the rocker is located below the surface of the rocker, the axis of the tappet must also be below that surface; but if the axis of the rocker should happen to be in line with the top surface of the rocker, then the axis of the tappet would also have to fall on that surface. Since there is no possibility whatever for a coaxial relationship between the axis of Schaefer's tappet and the rotational axis of members that do not rotate, appellee of course found it impossible to say just *what part* of the arms 32 and 34 are horizontally aligned with the nonexistent axis that appellee is trying to import into the Schaefer mechanism in order to support the lower court's findings.

According to appellee's argument, the hypothetical axis or symmetrical point is aligned with the arms 32 and 34 only "when the said arms are moved to a common level." In rocker and tappet tuners a coaxial relationship must prevail at *all* times, for it is only when these members are *tilted toward extreme angular positions* that creeping ever occurs. A coaxial relationship that prevailed only when these members are "moved to a common level" would thus not be the least helpful for the elimination of creeping.

Appellee alleges that Schaefer shaped his tappet in order to secure a coaxial relationship with the axis which appellee imports into his device. The shape of Schaefer's tappet has nothing whatever to do with a coaxial relationship nor with the elimination of creeping. The tappet can be shaped so that its axis is far above the bars 32 and 34 and creeping still will not occur. The axis of the tappet may also be moved sideways in either direction and the operation of the tuner will not change in the least unless parts actually strike each other due to lack of clearance.

Schaefer prevented creeping by separating his tappet from the rotatable member that is to be positioned and *by interposing ten movable parts between them, these parts having eight guides*. This was explained by Leishman at the trial (see Op. Br. pp. 25-28), and his testimony that Schaefer eliminated creeping by adding 18 extra parts was not disputed by anybody and he was not even cross-examined on the point.

(a) Had Appellee Not Waited Until After the Trial to Urge That Creeping Was Prevented in Schaefer's Tuner by an Alleged Coaxial Relationship, This Sophistry Could Have Been Exposed by Cross-Examination Before the Court as It Was in Oklahoma.

Appellee's post-trial argument that Schaefer prevented creeping by a coaxial relationship, is particularly pernicious because it was presented at a time when it could not be exposed by cross-examination and expert testimony before the trial judge. The sophism originated in the present form in The Richards and Conover case, where it was advanced by the attorney and expert opposing the patent, but the questions of Mr. Flam and Judge Chandler resulted in the expert's admitting that the argument was fallacious and that there was no coaxial relationship in the Schaefer structure and that the position of the axis of the tappet had nothing whatever to do with the elimination of creeping in Schaefer's tuner.

Believing that the same argument might be advanced in the trial of the present case, appellant came to court prepared to explode the sophism in an even more effective way than at the Oklahoma trial. He brought a Schaefer mechanism to court in which the axis of the tappet was as far above the points of engagement as the axis of the tappet in the Marschalk device, and the axis could be moved from side to side. In no case would creeping occur, because creeping is prevented in the Schaefer structure by the interposition of extra parts between the tappet and the rotatable positionable member. But appellee did not advance the Schaefer-coaxiality argument at the trial. The only explanation of how creeping was prevented in the Schaefer device was appellant's explanation, and it was not disputed. Leishman asked Mr. Flam if the model

should be introduced anyway, and Mr. Flam correctly replied that it would not be proper rebuttal because the argument advanced in Oklahoma had not been advanced here, and that appellant's own explanation of the Schaefer tuner would prevail because it had not been disputed on cross-examination and no opposing testimony of any kind had been offered.

Had either of appellee's experts contended at the trial that there is a coaxial relationship in the Schaefer device, or that such alleged relationship prevents creeping in Schaefer's mechanism, the fallacy of such testimony could have been shown just as it was in The Richards and Conover trial. While the admissions of the expert opposing the patent in that case are of course not a part of the present record and are therefore not binding upon appellee, this Honorable Court may nevertheless take judicial notice of what could have happened to the Schaefer-coaxiality argument had it been advanced as testimony in court. Appellee provided the Court with a copy of The Richards and Conover record, and it was designated by stipulation of both parties hereto as one of the exhibits on appeal [R. 684]. The pertinent parts are quoted in the appendix hereto, pages 1 and 2.

(b) Appellee's Brief Erroneously Alleges That Schaefer's Tuner Passes Appellant's Own Test for Coaxiality, but This Written Test Was Prefaced by the Statement That It Was Applicable Only to Tuners in Which the Tappet Presses Upon the Rotatable Member; and Since Schaefer's Tappet Is Separated From His Rotatable Member by the Interposition of Ten Movable Parts, His Mechanism Is Not of the Type for Which the Test Was Formulated.

Appellee states in two places (pp. 18 and 20) that "The Zenith tuner was admitted by the patentee to pass the

test for coaxiality which the patentee himself had prescribed for the industry." This is absolutely untrue. The test which appellant prescribed for the industry was a test for ascertaining whether there was a coaxial relationship in tuners containing adjustable members, or tappets, that *press upon the rotatable member*. Since Schaefer's tappets do *not* press upon the rotatable member but are isolated therefrom by the interposition of ten movable parts, the Zenith-Schaefer tuner is not even of the type for which the test was devised. Inasmuch as the test was only valid for tuners in which the tappet presses upon the rotatable member, the part of Leishman's letter prescribing the test was preceded by this caution [R. 700]:

"*If* such tuner includes push buttons that carry adjustable members or cams [tappets] that move around a center (real or imaginary) and *if* such adjustable members [tappets] press on one side of the rotatable part of the tuner [rocker] when the button is pressed, causing it [the rocker] to turn until stopped by the other side of the adjustable member [tappet], . . ." then the test is applicable, but in the Schaefer device the tappet does not press upon a rotatable member causing such member to rotate until it is stopped by the other side of the tappet, and it thus does not come within the class of apparatus for which the test was prescribed.

Appellee's counsel nevertheless insisted at the trial that Leishman apply the test to the Schaefer tuner, and Leishman's objections on the ground that the test was inapplicable to such a tuner extend from the middle of page 309 to the middle of page 311. Counsel made a second attempt

to get Leishman to apply the test to Schaefer's device, and the objections were as follows:

“The Witness: Your Honor, that test was one to apply to a tappet—

Q. (By Mr. Lyon): I am not asking the witness to argue the question. I am asking him to make the test.

Mr. Flam: I will make the objection because the test prescribed by the witness as set forth by the letter, relates only to rotatable rockers and adjustable tappets and this device doesn't have a rotatable rocker at all.” [R. 314.]

It might be said if we are dealing with animals and should find one which has four legs that such animal is a quadruped. But the test cannot be applied to chairs and justify the conclusion that a four-legged chair is a quadruped.

The statements in appellee's brief (p. 20) that “the Zenith tuner was admitted by the patentee to pass the test for coaxiality which the patentee himself had prescribed for the industry” is thus both untrue and malicious. Such efforts to import a coaxial relationship into Schaefer's device are an excellent demonstration of the fact that appellee has nothing substantial upon which to base its case.

None of the prior decisions or findings has recognized any coaxiality in the Schaefer mechanism. Judge Harrison's opinion said (36 Fed. Supp. 804 at 808): “The adjustable means used by the plaintiff was similar to Schaefer's and the coaxial feature was used solely to prevent play at the time of adjustment.” This clearly signifies that Leishman's adjustable tappet and the means for clamping it in position are similar to that used by Schaefer,

which is true; but the coaxial feature referred to is clearly the coaxial feature in Leishman's own mechanism.

Judge Chandler in the Oklahoma case referred to the Schaefer structure in Finding 19 [Richards and Conover record, p. 31], which reads as follows:

“19. Schaefer, exhibit 20, Marschalk, exhibit 18, Lane and Mackey, exhibit 22, and Soffietti, exhibit 21, in Italy all tried to produce acceptable tuners using an adjustable tappet, but their tuners were all either more complex or much harder to adjust than plaintiff's simple structure.”

The Court of Appeals for the Tenth Circuit recognized no coaxiality in the Schaefer device, but said (172 F. 2d 365 at 372) that:

“. . . he (Dr. Spotts) testified that where the rocker is mounted on a rotatable shaft, rather than as in prior patent to Schaefer No. 1906106, substantial coaxiality between the axis shafts and pin A would be necessary to avoid creeping.”

This is certainly a recognition that there was no coaxiality in the Schaefer mechanism, but that coaxiality would be necessary if a rocker were used instead of all the extra parts employed by Schaefer.

Most anybody knows what an axis is. It therefore should be *obvious* to most anyone that nothing in the Schaefer tuner is at any time coaxial with the axis of the tappet. The attempt to import a coaxial relationship into the Schaefer mechanism by sophistry, merely shows the extremes to which appellee must go to try to produce something to sustain the lower court's findings about the Marschalk and Schaefer devices.

Findings 8 and 9 are manifestly clearly erroneous. The Marschalk and Schaefer devices do not anticipate Leish-

man and do not teach that creeping may be eliminated by the provision of a coaxial relationship between the axis of the tappet and the rotational axis of the rotatable member that is to be angularly positioned. Marschalk's device merely demonstrates the difficulty that must be overcome when using an adjustable tappet, and it shows that Marschalk himself knew of no way to do it. Schaefer's device demonstrates that the engineers of the Zenith Corporation knew of no better way to eliminate the creeping difficulty than by the interposition of ten movable parts between the tappet and the rotatable member that is to be angularly positioned, these movable parts requiring eight guides.

V.

In Its Argument With Respect to Cunningham's Gas Measuring Device, Appellee's Brief Ignores the Fact That Cunningham's Alleged Tappet Never Has to Be Adjusted to the Position of His Rocker, and That Nothing in His Mechanism Deals With a Problem Similar to the Creeping Problem That Arises in Adjustable Tappet Tuners. Appellee Cites No Authority That Says a Non-analogous Device May Be Altered in Structure and Operation and Passed Off as an Anticipation.

The "creeping" problem solved by appellant was never presented in the Cunningham gas-measuring device, and this device therefore cannot be urged as anticipating appellant's solution of the creeping problem. The peculiar "creeping" difficulty arises, as this court knows, when the tappet is being set to conform to the exact angular position that the rocker occupies when the desired station is tuned in. This "setting" is done by bringing the loosened tappet into firm engagement with the adjusted rocker so that the tappet will assume the same angular position as

the rocker. If the rocker is tilted, the pressure of the loosened tappet causes both the rocker and the loosened tappet to turn away from the adjusted position, and an accurate setting therefore cannot be effected. In Cunningham's device, the part that appellee calls "the tappet" is never set to conform to the position of the rocker; in fact, it is never brought into engagement with the rocker excepting when it is firmly clamped against all rotation. The situation that causes creeping in an automatic tuner is thus never present.

The part that appellee calls "the tappet" in the Cunningham device is adjusted periodically to conform to the height of a float that rises or falls with the pressure of flue gas, and it is always adjusted *when completely disengaged from the rocker*. After it is thus adjusted and clamped in position, it is then brought into contact with the rocker in order to move the rocker to the position to which the tappet was adjusted, this position having been determined by the height of the float in response to the pressure of the flue gas.

This is all admitted in the testimony of appellee's own expert, as shown in Appellant's Opening Brief, pages 56 to 60. Cunningham's device is thus completely non-analogous and was not used to solve an analogous problem. Furthermore, Cunningham's device had to be materially altered in order to simulate appellant's structure. (See pp. 60-64 of the Opening Brief.) Such a device does not anticipate. The law on this point was fully set forth and discussed in Appellant's Opening Brief.

In the trial of *Leishman v. The Richards and Conover Co.*, Judge Chandler dismissed the Cunningham device in the same way and for the same reason that this Honorable

Appellate Court dismissed the railway truck or "bogie" art in the *Six Wheel* case. Regarding the Cunningham mechanism, Judge Chandler succinctly said: "You mean to say the question doesn't arise." [P. 82 of the Richards and Conover record, which appellee has filed for the court's information.] In the *Six Wheel* case, this Honorable Court dismissed the bogie truck art, as "a non-analogous art having different problems." Cunningham's device is likewise from a non-analogous art having different problems.

It is difficult to see why appellee cites the Supreme Court decision in *General Electric Co. v. Jewel Incandescent Lamp Co. et al.*, 326 U. S. 242, 90 L. Ed. 43, in support of its argument that the Cunningham patent has pertinence here. This decision deals, as appellee's own brief shows, with a situation *in which no changes were required*. The patentee had merely found a new use for an old process. In the instant case, appellee's model purporting to represent a portion of the Cunningham mechanism *was a departure both in structure and operation* from what Cunningham disclosed—all of which was admitted by appellee's own witness, as pointed out in Appellant's Opening Brief at the places hereinbefore mentioned. The *General Electric* case is thus inapplicable. The doctrine that applies here is that expressed by the Supreme Court in *Topliff v. Topliff*, 145 U. S. 156 at page 161:

"It is not sufficient to constitute an anticipation that the device relied upon might, *by modification*, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions." (Emphasis added.)

Appellee's brief mentions that the *General Electric* decision quotes from *Ansonia Brass & Copper Co. v. Electrical Supply Co.*, 144 U. S. 11, 36 L. Ed. 327, as follows:

“* * * ‘the application of an old process to a new and *analogous purpose* does not involve invention, even if the new result had not before been contemplated.’” (Emphasis added.)

That, too, is inapplicable. As fully demonstrated in Appellant's Opening Brief and reiterated herein, appellant's purpose is *not analogous* to that of Cunningham.

There is no decision anywhere that says an infringer can take an old device and alter it in structure and in mode of operation and then pass it off as an anticipation of the patent whose teachings he desires to appropriate.

VI.

Appellee Attempts to Defeat the Evidence of Invention by Saying That Coaxiality Is a Common Expedient, But Appellee Neglects to Mention That the Purposes for Which It Has Been a Common Expedient Are Vastly Different From the Purposes Here and That Appellee's Own Expert Admitted That He Knew of No Instance Anywhere in Which It Had Ever Been Used for the Unorthodox Purpose of Preventing Unwanted Rotation of Engaging Members. Invention Cannot Be Disproved by Showing That Its Elements Are Individually Old.

The argument which appellee presents in this regard is the argument which confused Judge Harrison in the *Associated* case. The Court of Appeals for the Tenth Circuit did not at first see the fundamental error that appeared in Judge Harrison's decision regarding previous

uses of coaxiality and accordingly found it necessary to base its second opinion upon other grounds. This was pointed out on pages 4 to 6 hereof. This Honorable Court, however, has clearly stated the applicable law as follows:

“* * * invention cannot be defeated merely by showing that, in one form or another, each element was known or used before. (Citing many decisions.)

“The question is: Did anyone before think of combining them in this manner in order to achieve the particular unitary result, a new function? *If not, there is invention.* (Citing many more decisions.)”

Pointer, d. b. a. Pointer-Williamette Co. v. Six Wheel Corporation. 177 F. 2d 153, 160. (The court's own emphasis.)

Neither appellee nor anyone else opposing the patent here at issue has ever alleged that a coaxial relationship between two engaging members has ever before been used to prevent unwanted rotation. Appellee's own expert testified that he knew of no such prior use. His testimony was quoted on page 68 of Appellant's Opening Brief and it therefore need not be repeated here. The significance of his admission was discussed in the first two paragraphs on page 69 of the said Opening Brief.

It is easy to make generalizations, as appellee does about former uses of coaxiality. But the inapplicability of generalizations can often be shown by requiring specific examples, as was done at the trial by Mr. Lyon himself when appellee's own expert Schwarz made the vague and meaningless generalizations now referred to in appellee's brief as follows (p. 41):

“He further testified that the principle of coaxiality is understood by machine designers, that it is a mere

application of a principle of engineering amounting to the elimination of all moment arms, and that such principle was known to engineers from the time of his schooling. Furthermore, he testified that the elimination of moments by making things line up concentrically or coaxially is a well-known and well-established principle of engineering."

Pressed for something more specific, Mr. Schwarz gave his testimony about a prick punch and a V-block, quoted in full on pages 12 to 13 of the Appendix to Appellant's Opening Brief. Mr. Schwarz' example was illustrated on page 12 of the said appendix and the discussion on pages 13 to 15 of the appendix showed that Mr. Schwarz' example was totally irrelevant and had nothing whatever to do with coaxiality.

To prove the irrelevant contention that coaxiality *per se* was old, appellee's brief quotes the testimony of Leishman's expert Loehr as it appeared in Judge Harrison's decision in the *Associated* case. Judge Harrison quoted Mr. Loehr in support of the statement in his opinion (36 Fed. Supp. 804, 808) that "The importance of the mechanical relationship [coaxiality] is well known in the art and a feature that must be considered in all machine designing when you desire parts to move together harmoniously and free from friction. The same principle is used in the crank shaft of any automobile.⁴ It is a mechanical principle that is hundreds of years old. Both

⁴The principle of a coaxial relationship is not used, and cannot be used, in the crank shaft of any automobile. A crank shaft has only *one* axis. Since "coaxial" means "having coincident axes," the first requisite for coaxiality is that there be two or more members each with an axis; and the second requirement is that these two axes be coincident, or exactly in line.

the experts of the plaintiff and the defendant agree in this respect."

Immediately after the foregoing statement in his opinion, Judge Harrison quoted the portion of Mr. Loehr's testimony that appellee has requoted in its brief. Judge Harrison said:

"The plaintiff's expert Leslie K. Loehr, testified as follows:

Q. Whenever you have two members that you want to turn together in the same orbit or to maintain contact with each other as they are turning together, you know that they should be on-center, isn't that correct? A. Well, they may be coacting in such a way that the resultant would be a center.

Q. The resultant; either they are actually on-center or the result amounts to the same thing; isn't that correct? A. Yes; so they will function together.

Q. In other words, this matter of putting these members on-center is one of the common tools and one of the common experiences of a machine designer? A. Yes. *If you have reference to machine elements in a machine; yes.*" (Emphasis added.)

Judge Harrison thus quoted Mr. Loehr's testimony in support of the statement in his opinion that coaxiality was well known and that it is a feature that must be considered in all machine designing when you desire parts to move together harmoniously and free from friction. Inasmuch as these cited uses of coaxiality for enabling parts to move together harmoniously and free from friction are diametrically opposite from Leishman's use of coaxiality

for preventing parts from moving at all, the portion of Mr. Loehr's testimony quoted by Judge Harrison actually constitutes much better evidence of the reason for the dilemma that faced those who tried to solve the *creeping* difficulty. Since coaxiality had been used for hundreds of years when you want parts to move together harmoniously, it was quite natural and logical that no one would think of using coaxiality to *prevent* two members from moving at all. One does not conclude that because a sieve permits water to run through freely it would constitute an excellent vessel for holding water. It used to be considered that disease could be cured by bleeding people, but this can hardly be held to have suggested the idea of giving them blood transfusions.

Appellant's unorthodox use of coaxiality for *preventing* movement was exactly opposite from the purposes for which it had been used as a common expedient. Regarding the solution of the problem that was presented in six wheel trucks, this Honorable Court said (177 F. 2d 153, 161):

“Knox, in solving it, deviated from the entire prior art. *He was an innovator, not a follower.*” (The court's own emphasis.)

In view of the nature of the previous uses of coaxiality “for hundreds of years,” as Judge Harrison put it, it is clear that appellant deviated from the entire prior art in a more marked degree than did Knox, and that Leishman also was an innovator, not a follower.

VII.

The Success of Coaxial Tappet and Rocker Tuners Was Not Due to the Development Work of the Crosley Corporation, as Appellee Contends, Because Plungers Were Old in the Art and the Crosley Corporation Was Admittedly Unable to Produce a Satisfactory Plunger-operated Tuner Until It Adopted the Coaxial Tappet and Rocker Construction Developed by Leishman. All Credit for the Success of These Tuners Must Therefore Go to the Coaxial Tappet and Rocker Construction.

It is absurd to contend, as appellee does, that the success which has attended the coaxial tappet and rocker tuners manufactured by General Motors and others is due to the development work of Crosley. What part of this combination was new? Certainly not the plunger. What part was developed by Crosley? Certainly neither the plunger nor the coaxial tappet and rocker. plungers had been used to move tappets ever since the days of Kettell in 1883. (See Opening Brief p. 14 *et seq.*) A plunger moved the tappet in Fig. 10 of the Woodbridge patent granted in 1897. (Insert at the back of Appellant's Opening Brief.) A plunger moved the tappet of the tuner in Fig. 1 of the Danish patent No. 52,047, granted in 1936. (Opening Brief p. 112.) plungers were also used to operate the tuners of Marvin 1,704,754 [No. 3 in the Book of Patents introduced as Defendant's Exhibit A with Defendant's Motion for Summary Judgment], Bast [R. 1142], Faas [R. 1145] and Morin [R. 1172].

According to the testimony of Mr. Kilgour, the plunger or push button was what Crosley *started with* [R. 504], and the research was to determine what would be operated by the plunger. They worked all summer and in

the fall were about to go into production on the tuner with which they had been experimenting [R. 504], “*but it seemed to be a rather difficult one to work out practically.*” They then switched over to the coaxial tappet and rocker construction [R. 504], which everyone knows *did* work out practically. But did the Crosley Corporation actually develop this? The Crosley Corporation does not even claim to have had any idea of such a mechanism before October, 1937.⁵ Leishman’s parent application disclosing this construction was applied for in December, 1934—three years earlier than this, as shown in the heading of the

⁵This was the month that the Crosley Corporation, seeking an answer to their difficulties, asked the law firm of Allen and Allen to investigate Mr. Leishman’s patent No. 2,084,851. This is stated in black and white in the letter of Allen and Allen to Leishman, which appears as Defendant’s Exhibit AA on page 1063 of the present record. The file wrapper of that patent included the specifications and drawings of the patent here at issue. This file wrapper is in evidence as Exhibit O, and the drawings will be found on page 888 of the present record. No one in the Crosley organization ever denied having this information right before them when they switched over to the coaxial tappet and rocker construction. When Mr. Leishman accused them of this piracy in the trial of the *Associated* case which Crosley defended, Mr. Kilgour, who was in charge of research at the Crosley Corporation, was right in the courtroom. But did Mr. Lyon put him on the stand to tell what he knew about it? No. The Kilgour testimony has all been incorporated as a part of the present record by stipulation of both parties hereto, but it contains not a word about this. Instead of putting Mr. Kilgour on the stand to deny Mr. Leishman’s accusations, Mr. Lyon called his associate counsel, Mr. Yungblut, to rebut Mr. Leishman’s accusation. He testified:

“* * * we had no file history of patent No. 2,084,851 until March, 1938.” [R. 525.]

“Q. Have you any information that any member of your firm or any representative of the defendant in this case ob-

reissue patent [R. 777] and in the file wrapper of the parent application on page 844 of the present record. The drawings appear in this 1934 application at page 888 of the present record, and the portion that was carved out to form the specification of the divisional application on the coaxial tappet and rocker construction is shown on pages 863 to 865.

Neither appellee, nor Crosley, nor anyone else has denied that Leishman is the originator of the coaxial tappet

tained any information from the files at Washington? A. No, they did not.

Q. Do you have any reason to believe that they did? A. No. In fact, I know they did not." [R. 526.]

In the absence of some explanation for the long delay, it is not plausible that Mr. Yungblut's firm would not have a copy of the file history of this patent until March, 1938, when his valuable client, the Crosley Corporation, asked him to investigate the patent in October, 1937.

His testimony as to what anyone did at the Crosley plant is, of course, only hearsay. The one man who was in a position to give competent testimony as to what went on at the Crosley plant was Mr. Kilgour. The real significance of Mr. Lyon's failure to ask Kilgour to testify on this point, and his substitution of his associate counsel, is evident from the following expression of the Supreme Court in *Kirby et al. v. Tallmadge*, 160 U. S. 379, 383, 40 L. Ed. 463, 465:

" . . . It would certainly have been much more satisfactory if the defendants, who must have been acquainted with all the facts and circumstances attending this somewhat singular transaction, had gone upon the stand and given their version of the facts. *McDonough v. O'Neil*, 113 Mass. 92; *Com. v. Webster*, 5 CUSH. 295, 316, 52 Am. Dec. 711. It is said by Mr. Starkie, in his work on Evidence (vol. 1, p. 54): 'The conduct of the party in omitting to produce that evidence in elucidation of the subject-matter in dispute, which is within his power and which rests peculiarly within his own knowledge, frequently affords occasion for presumptions against him, since it raises strong suspicion that such evidence, if adduced, would operate to his prejudice.' "

and rocker construction. To say that the success of the coaxial tappet and rocker tuners is due to work done by Crosley is thus not in accord with the facts. The plunger that moved the tappet was very old, and the only departure from the prior art was the coaxial tappet and rocker construction that was developed by appellant. All credit for the commercial success of these tuners must therefore go to the developer of the coaxial tappet and rocker construction, and that person was Leishman.

Appellee claims that the Schaefer tuner, originally operated by a lever, was a success (p. 33 of Brief for Appellee), using the number of tuners in which the Schaefer mechanism was operated *by a plunger* as the measure of this success; but when appellant, in measuring the success of his coaxial tappet and rocker combination, includes those that were *plunger*-operated, appellee claims that this is improper. Even if we measure the success of the coaxial tappet and rocker combination solely by comparing the various plunger-operated tuners used by General Motors, we find that by far the greater success went to those containing coaxial tappets and rockers, for appellee abandoned the Schaefer-General Motors rack tuner in favor of the coaxial tappet and rocker construction, of which more than one million were manufactured prior to the trial. Appellee could have used the rack construction without having to consider appellant's patent, but General Motors' preference for appellant's construction was so great that it brought this law suit in order to secure permission to use it without paying Leishman anything for the privilege.

VIII.

Appellee's Attempts to Belittle Appellant's Combination in Its Brief and at the Trial, Comes With Poor Grace From a Corporation That Has Abandoned Its Own Structure and Used That of Appellant in More Than a Million Tuners.

Although appellee has abandoned all other tuners and admittedly used appellant's coaxial rocker and tappet combination in more than a million radio receivers prior to the trial, appellee's brief nevertheless says (p. 35) that "simple inspection" of *appellee's* purported model of this construction "makes it evident that this so-called invention is indeed but a poor answer to the problem, if one existed, posed by Marschalk." Yet this greatest of all corporate giants filed this law suit in an attempt to secure the court's permission to continue to use this "poor answer" in a few more million radio receivers. Appellee's anomalous position is evident from the following decisions:

"* * * It has been held in adjudications without number, that one who appropriates the teachings of a patent may not deny the utility of the invention. This is, of course, both reasonable and logical."

United States Gypsum Co. v. Consolidated Expanded Metal Companies (C. C. A. 6), 130 F. 2d 888, 889.

This Honorable Court expressed the same well-known doctrine in *Dunkley Co. v. Central California Canneries et al.*, 7 F. 2d 972, 976, 977:

"On the other hand, the defendants, having used machines which embody plaintiff's patent, cannot be heard to dispute the utility of the patent. *Lehnbeuter v. Holthaus*, 105 U. S. 94, 96, 97, 26 L. Ed. 939; *International Tooth Co. v. Hanks Association* (C. C.)

111 F. 920, 921; same case affirmed, 122 F. 74, 58 C. C. A. 180; Cummer & Son Co. v. Atlas Co., 193 F. 993, 997, 113 C. C. A. 611; Boyce v. Stewart, 220 F. 118, 126, 136 C. C. A. 72."

Appellee nevertheless went to considerable lengths to build a spurious model purporting to show appellant's construction. [Pltf. Ex. 5.] Regarding this model, with built-in defects of appellee's design, appellee's brief (p. 35) says:

"Neither rocker [after the tappet had been set] returned to its proper position, and Schwarz explains that such failure was due to the high step-up in the structure and to its ineffective lock-up design, and that the mechanism would not be commercially satisfactory."

The failure of the rocker to return to its proper position was due to the hard turning condensers deliberately used by appellee and to changes which appellee made in the lock-up design in order to make the lock slip. No such difficulties arose with the model constructed by appellant. [Defts. Ex. M.]

When appellee's model [Pltfs. Ex. 5] was first introduced, Mr. Flam made many objections to it because it was "almost impossible, without the use of a great deal of force," to move the rockers and tappets [R. 356]; and after Mr. Schwarz finally admitted that there was binding in the shafts, Mr. Flam's renewed objections were sustained [R. 362] and Mr. Lyon secured the court's permission to let Mr. Schwarz take the model away to "loosen it up some." The model was returned to court the next day in a somewhat improved but still unsatisfactory form.

In disclosing his novel contributions to the field of automatic tuning, there was no necessity for Leishman in his patent to describe any particular kind of means for locking the tappets in adjusted position. The kind of lock is immaterial. A locking means could have been indicated diagrammatically, or it could have been omitted entirely. Suitable locks were already well known in the art, and the Supreme Court long ago held that ". . . That which is common and well known is as if it were written out in the patent and delineated in the drawings."

Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, at 437.

But in building a model of defendant's tuner, plaintiff not only made no use of "that which is common and well known" but deliberately departed from the disclosure in the patent in order to misrepresent defendant's invention. Appellant's model [Defts. Ex. M] shows that the lock illustrated in the patent is adequate to hold the tappet; but if it were not so, any worker in the art would be expected to make use of "that which is common and well known." The end of the clamp illustrated in dotted lines in the patent is formed like the letter V, but instead of using a V-lock on its model of appellant's tuner, appellee used one that is circular or arcuate in shape so that it would slip.

But General Motors pays the patent the tribute of imitation, and Mr. Schwarz inadvertently admitted the great value of constructing the tappet and rocker so that their axes are coaxial, although he was apparently trying to damn the construction by faint praise. He said [R. 349-350]:

"A. Coaxiality is a good design feature, but not one of major importance. We feel that there are

many other items of the tuner design that might swamp out the improvement which might be gained by the coaxiality. For example, the fit of the bearings, or a burr on the tappet, or a bent tappet would overcome any good that might be gotten from coaxiality. In other words, coaxiality is a good feature, but it is not the only feature which must be considered in the design of a tuner to be accurate enough."

It should be quite obvious in any device that no improvement can be sufficiently great to become "the only feature which must be considered"; nor can any improvement be great enough to avoid being "swamped out" by mechanical difficulties elsewhere. It requires no stretch of the imagination to realize that any automatic tuner could be rendered entirely inoperable by "the fit of the bearings, or a burr on the tappet, or a bent tappet." A bent tappet in an automatic tuner is as serious as a broken crank shaft in an automobile. A statement that it takes difficulties of such magnitude to "swamp out" the advantages of appellant's coaxial relationship between the tappet and rocker, is a rather significant admission from a witness who is trying to minimize the importance of appellant's contribution.

But General Motors' major concession to the importance of appellant's combination is its own abandonment of other tuners, including the one designed by Schwarz and the other General Motors engineers [Plts. Ex. 3], and General Motors subsequent use of more than a million tuners embodying the coaxial rocker and tappet construction. And the Court should not lose sight of the fact that General Motors went to the expense of filing this Declaratory Judgment suit and fighting it through the courts rather than give up the advantages of appellant's contribution.

Of equal if not greater significance is what happened in connection with the Zenith Corporation. Zenith has been a major factor in automatic tuning ever since it filed the Heath patent in 1924. [R. 800.] Zenith engineers developed the Zenith-Schaefer tuner in which creeping was avoided by interposing ten movable parts with eight guides between the tappet and rotatable member. But it abandoned this. With the advent of appellant's coaxial tappet-and-rocker construction, Zenith returned to automatic tuners—in fact, Defendant's Exhibit FF is a Leishman tuner manufactured especially for Zenith by appellant's licensee. [R. 225-226.] Zenith later tried still other tuners; but in May, 1948, Zenith returned to the coaxial tappet-and-rocker construction [Defts. Ex. GGG] with the announcement that "This system is so simple and fool proof, that complete replacement should seldom, if ever, be necessary." [R. 1140.]

The engineers of the Crosley Corporation worked from the spring of 1937 until October, 1937, in the development of a tuner of their own [R. 504] "but it seemed to be a rather difficult one to work out practically," so they switched over to the coaxial tappet and rocker construction. [R. 504.] This Honorable Court is well aware through the *Associated* case that Crosley, like General Motors, defended a law suit rather than give up this feature.

This Court is also aware through the *Radio Condenser and General Instrument* case that the tuners made by these concerns were also of the coaxial tappet and rocker construction. The decision in the government's suit against these tuner manufacturers shows (87 Fed. Supp. 157, 180, 182) that they authorized their jointly owned Condenser Development Company on June 9, 1939 (p. 180) to

respond to a charge of "alleged infringement of any Letters Patent in the field of radio tuning devices" by taking appropriate "affirmative action" such as "the devising of structures in avoidance of infringement thereof" (p. 182). The complaint in the Declaratory Judgment suit which these concerns brought against Leishman shows on page 5 of the printed record in this Court's possession (No. 11652) that they were aware of Leishman's charges of infringement in 1938. Yet as late as 1945, the date of the complaint, neither these concerns nor the Condenser Development Company had been able to develop a satisfactory tuner that would obviate the use of Leishman's construction, so they filed a Declaratory Judgment suit against him to secure the court's permission to continue its use over Leishman's objections.

This history shows the importance of appellant's contribution far too convincingly for appellee to belittle it successfully.

IX.

Appellee's Contention That Appellant's Brief Has Pointed to No Evidence of Invention Ignores the Detailed Exposition of Such Evidence in the Opening Brief.

Alleging that the indicia of invention present in the *Six Wheel* case is missing here, appellee's brief asserts (p. 29): "The evidence in this case shows no long-felt want, no record of unsuccessful efforts by others preceding appellant, and no superseding by appellant's tuner of that which had gone before, indeed no use whatsoever of appellant's tuner." In the same vein, appellee's brief alleges (p. 34) that "the record establishes that rather than showing wide experimentation demonstrating a need for

his asserted solution the experimentation inferred from the evidence was not directed to the narrow problem allegedly posed by the Marschalk structure, which problem could not have been present prior to 1937, but rather, concerned entirely different type tuners. No evidence whatsoever establishes either that the art prior to appellant needed his alleged invention, that any problem existed requiring his alleged invention, or that anyone preceding appellant engaged in any unsuccessful attempts to reach the alleged invention."

It was thoroughly demonstrated in Appellant's Opening Brief in a well-documented exposition of the facts, that the indicia of invention prescribed in the *Six Wheel* case is present here in far greater degree than it was in that case. This was all set forth on pages 79 to 87 of the Opening Brief, to which the Court is respectfully referred.

It was shown on page 3 of the Opening Brief that some of the largest corporations in the country had been seeking for a satisfactory automatic tuner ever since 1924. But appellee contends that the experimentation "was not directed to the narrow problem allegedly posed by the Marschalk structure." It has been abundantly shown in appellant's discussions of the Marschalk tuner in this and the opening brief, that the problems of adjustable tappet tuners did not originate with Marschalk but confronted every experimenter who undertook to position a rotatable member by an adjustable tappet. The fact that others tried to obtain results by more complicated devices and by still other principles is strong evidence that he who succeeds by simpler means in producing a satisfactory article has done something that rises above mechanical skill. The law on this point is too well covered in the opening brief to need repetition here.

A few simple questions about the instant challenger of the patent may serve to bring the pertinent facts to a focus. If the answers to the problems of adjustable tappet tuners are all found in Schaefer, why didn't General Motors continue to use its own plunger-operated version of the Schaefer device instead of filing this law suit? If appellant has done nothing that Schwarz was not taught to do in school, why didn't Schwarz and his fellow-engineers produce appellant's simple device when they were endeavoring to simplify the Schaefer mechanism? If Marschalk teaches everything that Schaefer did not know, why did Marschalk, who must have known of the widely used Zenith-Schaefer tuner, leave the bugs in his own device? If appellee's simple solution was obvious all the time to any skilled worker in the art, why did Schwarz tolerate two extra parts for every button in the General Motors rack tuner?

X.

The Evidence and the Pertinent Law Show That the Reissue Patent Is for the Same Invention as the Original and That the Invention Intended to Have Been Covered by the Original Patent Included the Coaxial Relationship.

Appellee's brief attacks the validity of the reissue patent on two grounds: (1) That the reissue is not for the same invention as the original unless it includes levers, and (2) that the reissue is not for the same invention as the original because the reissue includes claims directed to the coaxial relationship between the tappet and rocker.

The first of these two grounds, having to do with whether the reissue claims must be confined to lever-operated devices, will be discussed under the subject of infringement.

With respect to its second ground for asserting that the reissue is not for the same invention as the original, appellee makes the statement in the very first paragraph directed to this defense that "no vestige of intent appears upon the face of the original patent to cover or secure coaxiality as appellant's invention." (Brief for Appellee, p. 58.)⁶

⁶After improperly referring to the Crosley tuner as an independent development, plaintiff's brief on page 59, says: "although he now denies it, he admitted in the *Associated* case that he modified the claims of his original patent in the reissue so that they would cover the Crosley tuner [R. 300-302] and, in so doing, claimed coaxiality." A careful reading of the pages referred to reveals that there is no conflicting denial and admission such as appellee alleges. The actual reasons for the reissue are set forth in appellant's oath at the time the reissue was applied for [R. 763]. This written document is in full harmony with appellant's testimony in the instant case as well as that in the *Associated* case, which appellee's counsel read into the present record in the pages referred to.

The question to which appellant answered "no" in the trial in the instant case was not the same question as that to which he answered "yes" in the *Associated* case. Appellee's counsel in the instant case asked Mr. Leishman [R. 301]: "Was one of your purposes in applying for the reissue patent in suit to so modify the language of the claims of your original patent that you could eliminate the question of non-infringement which was asserted by Allen & Allen at the meeting I have just referred to?" Mr. Leishman's answer to this question was "no." That this was the correct answer to this question is immediately apparent upon examining the language of the claims of the original patent as they reappeared in the reissue. Not one single word was altered.

The significance of Mr. Leishman's testimony on this point in the *Associated* case, which Mr. Lyon read into the present record, is fully discussed in the appendix hereto, pp. 4 to 6.

That the Crosley tuner was not independently developed, as appellee's brief alleges, was thoroughly demonstrated on pages 36 to 39 of this brief, and Crosley did not use this structure until after the corporation wrote the law firm of Allen & Allen [Deft. Ex. AA, R. 1063] asking it to investigate Leishman's patent No. 2,084,851, the file wrapper of which contains the original disclosure of this construction. Crosley Corporation learned of this '851 patent when Mr. Leishman made a second trip to the Crosley plant upon invitation of the chief engineer [R. 210-212] during the time that the corporation was trying to develop a satisfactory tuner of its own.

Appellee's misuse of the word "vestige" leaves appellee's exact meaning uncertain. It appears that appellee is alleging that no indication of such intent appears in the original patent. It is true that appellant never intended to claim coaxiality as his invention. Furthermore, he has never at any time made an attempt to do so. Appellee's statement to this effect is typical of appellee's many attempts to confuse the issue. Coaxiality has been used for many purposes in the past, but for none that was remotely analogous to appellant's novel use of this relationship. The claims in which a coaxial relationship is mentioned define specific elements and the relationship between the axes of these specific elements in the fully engaged position, and there has been no attempt to "secure coaxiality as appellant's invention," as appellee puts it. Claim 8, for example, says [R. 779, column 1, lines 16-19]: "The axis of said means [the tappet] being substantially coaxial with the axis of said rocker when said means is in engagement with both of said arms" [the arms of the rocker]. To assert that appellant is trying to claim coaxiality, is on a par with the situation that would have prevailed if the appellant in *Pointer v. Six Wheel Corp.*, 177 F. 2d 153, 160, had told this Honorable Court that Knox was trying to claim the universal joint as his invention. Knox used a universal joint for a specific purpose that was novel, and this Court held that ". . . invention cannot be defeated merely by showing that, in one form or another, each element was known or used before." (Citing many decisions.)

Appellee would have this Court believe that no reissue is valid unless its claims are identical to those of the original patent, or that intention to claim every subcombination must be individually set forth in the specification. Actually, appellant has never seen a patent in which it

was specifically stated that the patentee intended to patent this or that feature. The accepted procedure is merely to state the objects and then to describe a structure that achieves all the objects.

It is fundamental that every reissue must be for the same invention intended to have been covered by the original patent. The law is well settled on that point. The whole question is, what have the courts considered sufficient evidence of intention to claim? The Supreme Court long ago stated and later reaffirmed that a patentee may include in his reissue claims whatever was "substantially indicated in the specification or drawings which properly belonged to the invention as actually made and perfected." This statement was originally made by the Supreme Court in *Seymour v. Osborne*, 11 Wall. (78 U. S.) 516, 20 L. Ed. 33, which the Supreme Court cited with approval in its recent decision in *Graver Tank and Mfg. Co. v. Linde Air Products Co.*, 70 S. Ct. 854, 856. In *Parker and Whipple Co. v. Yale Clock Co.*, 123 U. S. 87, 97, 98, 31 L. Ed. 100, the Supreme Court quoted from its *Seymour v. Osborne* decision as follows:

"* * * Power is unquestionably conferred upon the commissioner to allow the specification to be amended if the patent is inoperative or invalid, and in that event to issue the patent in proper form; and he may, doubtless, under that authority, allow the patentee to redescribe his invention and to include in the description and claims of the patent not only what was well described before, but *whatever else was suggested or substantially indicated in the specification or drawings which properly belonged to the invention as actually made and perfected.*" (Emphasis added.)

There surely can be no question in anyone's mind that the coaxial relationship between the tappet and the rocker "properly belongs to the invention as actually made and perfected," to use the Supreme Court's language. There never has been any exception to the rule that any novel structure shown in the drawings and mentioned in the specifications is a part of the original invention if such structure was a part of the invention as originally made.

Following the doctrine long ago established by the Supreme Court in *Seymour v. Osborne* and reaffirmed in the *Parker v. Yale* case, the Court of Appeals for the Fourth Circuit recently said:

"It is argued that the reissue patent is for a different invention from that covered by the original patent and hence invalid, the contention being that the claim of the original patent covered a tobacco curing barn without reference to the device for bringing air from the outside over the open flame burners and under the hood, which is the heart of the combination covered by the reissue patent. The answer is that while the claims of the original patent broadly covered a tobacco curing barn and did not specifically mention the matter which made the combination patentable, *this was fully covered by the specification.*" (Emphasis added.) (*Florence-Mayo Nuway Co. v. Hardy, et al.*, 168 F. 2d 778, 782.)

There is certainly no question that the coaxial relationship between the tappet and rocker "was fully covered by the specification," to use the exact words of the Florence-Mayo decision. Moreover, the coaxial relationship was shown in the drawings.

Appellee tries to beg the question by saying (p. 58) that appellant "alluded briefly in his description to the

fact that the axes of the two tappets and two rockers therein described were coaxial and made no mention in the claims of coaxiality." The description of this feature of the invention is complete and thoroughly adequate and cannot be criticized on the ground that it is succinct. Whether any mention was made in the *claims* of the original patent as to this feature, is clearly immaterial according to the rule laid down by the Supreme Court in *Seymour v. Osborne*, reaffirmed in *Parker v. Yale*, and followed in the very recent *Florence-Mayo* case. In the *Florence-Mayo* case the decision states that the claims "did not specifically mention the matter," but that the feature described in the reissue claims "was fully covered by the original specification."

Although the inclusion of the coaxial relationship in the drawings and the description of it in the specification makes it entirely immaterial whether it was mentioned in the claims, appellee's expert Mackeown disagrees with the present statement of appellee's counsel and found language in the original claims which he *definitely* related to the coaxial relationship. In the affidavit of Dr. Mackeown, a part of which appears on pages 27 to 29 of the present record, Dr. Mackeown said at page 27:

"* * * In order to obtain coaxiality in the tuner of the reissue patent, because such tuner is operated by a lever, *it is necessary that the distance between the pin 60 and the pivot Q shall be equal to the distance between the pivot Q and the axis of the shafts 49 and S.* Moreover, the tappet 61 must be so shaped that, when the lever F is pushed home, the axis of the tappet will line up in a vertical direction with the axis of the rocker 48." (Emphasis added.)

The first requirement which Dr. Mackeown here tells us is necessary to secure coaxiality in the device shown in the patent, is set forth in both claims 1 and 2 of the original patent where the precise relationship specified by Dr. Mackeown is described. In referring to the tappets and the position of their pivot 60 with relation to the pivot or fulcrum Q of the lever, both claims 1 and 2 say:

“. . . a plurality of adjustable members pivoted to said lever at a point (the pin 60) substantially as far from the fulcrum of said lever (the pivot Q) as said axis (of the shafts 49 and S) is from said fulcrum (the pivot Q).” (Parenthetical references are to Dr. Mackeown’s language.)

Both claims 1 and 2 of the original patent thus describe the specific structure that Dr. Mackeown says “is necessary” “in order to obtain coaxiality” when a lever is used. Although, as before mentioned, the inclusion of the coaxial relationship in the original drawings and specification makes it immaterial whether the original claims embodied language directed to this feature, the above mentioned recitation in claims 1 and 2, the purpose of which is recognized by Dr. Mackeown, shows conclusively by the claims themselves that defendant was trying to claim the coaxial relationship in the original patent.

Aside from illustrating a coaxial relationship in the drawings and describing it in the specification of the original patent, which according to the Supreme Court is sufficient to support a reissue where the structure is a part of the device, there is yet another thing in the original patent that by itself constitutes definite proof of appellant’s intention to include the coaxial relationship of the tappet and rocker in his claims.

As this court has previously been apprised, the original patent resulted from a division of a parent application that was filed on December 15, 1934. The file wrapper of this parent application is present in the record as Defendant's Exhibit "O." Figs. 1, 2 and 3 of the original and reissue patents were originally Figs. 14, 15 and 16 of the parent application. These figures appear therein on page 888. The descriptive portion of the reissue patent will be found on pages 863 to 865, inclusive. While the identical drawings of the original patent thus appeared in the *parent* application, there was no verbal description of the coaxial relationship, but it has long been the custom of the Patent Office to require that anything covered by the claims must be both shown in the drawings and described in the specification. Inasmuch as the appellant desired to claim the coaxial relationship of the tappet and rocker, it was consequently necessary that this feature be specifically mentioned in the specification. In order to comply with this Patent Office requirement, a description of the coaxial relationship shown in the drawings was inserted when filing the divisional application that resulted in the original patent. This description appears in the file wrapper of *original* patent, No. 2,108,538 [Defendant's Exhibit "P"] at the middle of page 1008. The paragraphs above and below this description will be found in the file wrapper of the parent application [Defendant's Exhibit "O"] at the bottom of page 864, but it will be noted that the paragraph describing the coaxial relationship is missing.

The paragraph describing the coaxial relationship appears in the issued original patent *verbatim* on page 2 of the patent [R. 772, col. 1, beginning at line 30]. The specific insertion of this paragraph in the specification,

notwithstanding the fact that the coaxial relationship is adequately illustrated in the drawings, affords conclusive proof that appellant intended to claim this feature.

Another definite proof that Leishman intended to claim the coaxial relationship, is contained in the objects set forth in the second paragraph of the original patent. It is axiomatic that a patentee intends to claim the structure for achieving the objects which he enumerates. Everyone who is familiar with this patent suit knows that the purpose of the coaxial relationship between the tappet and the rocker is to make the apparatus *easy to adjust*, and the specification of the original patent states in black and white that one of the patentee's objects is "to afford means whereby the apparatus *may easily be adjusted* so that a definite manual operation will cause the desired rotatable element to be turned to a desired position." (Emphasis added.) [R. 771, col. 1, lines 30-33.]

The coaxial relationship was thus shown in the drawings of the original patent and described in the specification of the original patent, and the object which this relationship achieves was included in the objects of the original patent. Moreover, according to appellee's own expert, Dr. Mackeown, claims 1 and 2 of the original patent recite structure necessary to achieve the coaxial relationship, thus showing an actual attempt to claim this structural relation between the tappet and rocker.

According to the Supreme Court doctrine initially enunciated in *Seymour v. Osborne* and reaffirmed in *Parker & Whipple v. Yale*, it is enough to support a reissue if the structure claimed therein "properly belonged to the invention as actually made and perfected."

Appellee's argument that the reissued claims including the coaxial relationship are not for the same invention as the original patent are thus totally without merit.

XI.

The Doctrine of Equivalents as Reaffirmed by the Supreme Court in the Graver Case Shows Appellee's Plungers to Be Equivalents of the Operating Levers of the Patent, and the Clear Language of the Reissue Statute Requires That This Doctrine Be Applied to Reissue Claims in the Same Manner as to Original Claims.

Regarding the subject of infringement, appellee's brief contains not one word to support the proposition that the plunger in appellee's tuners is not the full mechanical equivalent of the lever shown in the patent. Appellee's argument in support of its contention of non-infringement is based solely upon this Honorable Court's decision in the *Associated* case. Regarding the present evidence as to the equivalence of plungers and levers that was not before this Court in the *Associated* case, appellee has nothing whatever to say by way of refutation, but contends rather that it is not new evidence. In the last analysis, appellee's claim of non-infringement thus rests solely upon this Honorable Court's decision in the *Associated* case.

Appellant is, of course, fully aware of this Honorable Court's holdings in that decision, but appellant has abundantly shown in the Opening Brief that appellee's plunger *is* the equivalent of the lever shown in the patent; appellant has shown, moreover, that a patentee is entitled in a reissue patent to claims that are broad enough to include the mechanical equivalents of the elements of the originally patented combination. The doctrine on this subject was quoted from Walker on Patents (page 118 of the Opening Brief), and the application of this doctrine to the specific facts of the present case is nowhere disputed in appellee's brief.

That a patentee has a right to reissue claims broad enough to include equivalents of the elements of his original combination, is a necessary corollary of the specific language of the reissue statute which says (Sec. 4916):

“* * * Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form * * *”

Certainly no one disputes that appellee would be entitled to claims broad enough to include equivalents if such claims had been filed *originally*.⁷ According to the statute,

⁷In this connection this Honorable Court may wish to take judicial notice of the fact that the Canadian Patent Office has allowed the identical claims here at issue in *an original patent*. Appellant is filing herewith as Appellant's Exhibit BBBB a certified copy of the allowed Canadian application on the tuner here involved. It will be noted that the drawings are absolutely identical to the drawings of the instant reissue and to the original thereof, and that the specification is verbatim the same, excepting for the first and next to the last paragraph, as the specification of these two United States patents. In allowing the same claims here at issue, the Canadian Patent Office thus agreed with the United States Patent Office that the reissue claims are for the same invention as the original.

The first paragraph of the Canadian application reads:

“This application is a division of my application Serial No. 442,750, filed June 21, 1937, and issuing on December 25, 1945.”

The next to the last paragraph of this Canadian application as allowed included this statement:

“. . . obviously the tappet and rocker will operate in the same way if the tappet is mounted on any other kind of operating means whatsoever, so long as such operating means transmits motion to the tappet and guides it into contact with the rocker. It will thus be clear that the tappet may be mounted upon a rectilinearly movable member, or plunger, without departing from the invention hereinbefore set forth.”

This statement was not challenged by the Canadian Patent Office, nor could it have been, because plungers and levers are probably the best known of all mechanical equivalents. In order to facilitate the verification that the said Canadian claims are the same as those here at issue, they are reprinted in the appendix hereto, pp. 6 to 10, where other pertinent information is given.

then, appellant cannot be deprived of the benefit of the doctrine of equivalents because the claims here involved are *reissue* claims. The right to equivalents is reaffirmed in no uncertain terms in the Supreme Court's recent decision in *Graver Tank Mfg. Co. v. Linde Air Products Co.*, 333 U. S. 271. There can thus be no doubt that infringement cannot be avoided by the substitution of a plunger for the levers shown in the patent, nor can it be said that the reissue claims are not for the same invention as the original patent unless they include levers. When an equivalent is substituted, the invention is still the same.

There is thus only one issue with respect to plungers and levers, and that issue is: Is the plunger of plaintiff's tuners the equivalent of a lever for moving the tappet?

According to the old doctrine of *Seymour v. Osborne* and *Imheauser v. Burke*, reaffirmed by the Supreme Court in its *Graver* decision, a plunger is the equivalent of a lever for operating automatic tuners or for moving tappets if it was known as a substitute for this purpose before the issuance of appellant's patents. Appellant's Opening Brief (pp. 112-113) showed that the earlier Danish patent No. 52,047 [R. 829] and Peck's U. S. Patent No. 1,865,704 [R. 1149] both taught the alternative use of plungers and levers for operating automatic tuners. The early patents to Faas [R. 1145], Bast [R. 1143], Morin [R. 1172] and Marvin [No. 3 in Defendant's Exhibit "A" with Motion for Summary Judgment] all show the use of plungers for operating automatic tuners. The use of plungers for moving tappets was taught in the very old patents to Kettell and Woodbridge discussed on pages 111

and 112 of Appellant's Opening Brief and cited as pertinent prior art in appellee's complaint [R. 7]. Plungers and levers are thus mechanical equivalents according to the formula prescribed by the Supreme Court.

Appellee's brief answers all this by saying (p. 56): "Such fact is immaterial here where we are concerned with the question of equivalency in a particular shaft positioning structure." In *any* patent case, the Court is concerned with equivalency in a *particular* structure. But if the immediate purpose of the asserted equivalents in the *particular* structure is no different from, or is analogous to, their purpose in prior art structures, then the asserted equivalents are also equivalents in the *particular* structure at issue. In the cited prior art tuners in which levers and plungers were used alternatively, they were used to transmit motion to the other parts that do the actual work of the combination. That is their use here. In the Kettell and Woodbridge patents cited in appellee's complaint as pertinent prior art, levers and plungers were used alternatively to move tappets. That is their use here.

Appellee has been unable to point to any difference between appellee's plungers and the lever of the patent that has any significance whatever. Appellee's brief says only: "The very fact that appellant in his testimony sought to minimize, that is, the traveling in an arcuate path by levers and in a straight path by plungers, is itself determinative of the issue of equivalency."

This difference between the action of levers and plungers, which is all that appellee has been able to point out, should, as appellee says, "itself be determinative of the issue of equivalency"; but this Honorable Court resolved this exact issue in the *Pointer v. Six Wheel* case by holding that parts characterized by this difference *are* mechanical

equivalents. As shown in Appellant's Opening Brief (pp. 114-115) this Honorable Court in its *Pointer v. Six Wheel* decision held that Pointer's coil springs that move in a straight line like plaintiff's plungers were equivalents of Knox' leaf springs that pivot in an arcuate path like the levers shown in appellant's patent. This was graphically illustrated on the folding insert at the back of the Appendix to Appellant's Opening Brief. The ruling of this Honorable Court on this point was the only logical one that could have been made, and it is controlling here.

In pointing out the difference, which is immaterial, between the action of levers and plungers, appellee's brief of course ignored the portion of Appellant's Opening Brief which showed that the significance of this specific difference had already been decided by this Honorable Court in a way that is unfavorable to appellee.

Appellee does not allege that it makes any difference whatever in the operation of a coaxial rocker and tappet tuner whether the tappet is moved in a straight line by a plunger or in a curved line by a lever. Most plungers move in straight lines like coil springs of the type used in Pointer's structure; and all levers, like the leaf springs of Knox, are pivoted to move in an arc. The distinction that appellee is now trying to grasp is not one that is peculiar to coaxial tappet and rocker tuners. The same difference that characterizes Pointer's coil springs and Knox' leaf springs also characterizes the plungers and levers in all the prior art devices that appellant has cited. But this difference had no significance in the Pointer and Knox structures. It likewise had no significance in any of the prior art tuners, and it in no way affected the coaction of the parts. It also has no significance in coaxial rocker and tappet tuners and it likewise in no way affects the coaction

of the parts. Levers and plungers were used as equivalents in all the prior art devices in which they were shown, and the fact that one moves in an arcuate path and the other in a straight path has no more significance in coaxial rocker and tappet tuners than it had in any of the tuners of the prior art.

In view of this Honorable Court's decision in the *Six Wheel* case and the Supreme Court's opinion in the *Graver* case, it can no longer be held that a plunger is not the equivalent of a lever for moving the tappet in appellant's combination, nor that the reissue claims must include levers in order to be for the same invention as the original. When a mechanical equivalent is substituted for one of the elements of a patented combination, it is still the same invention. The Supreme Court has repeatedly said (as in the reaffirmed *Seymour v. Osborne* and *Imheiser v. Burke* decisions) that one cannot omit an element of a patented combination and substitute a known mechanical equivalent and avoid infringement. If such a substitution changed it into a different invention, the Supreme Court certainly would not have said that infringement cannot be avoided in this manner. There would be no infringement if the accused device did not embody the invention covered by the claims which the device is alleged to infringe. The fact that the Supreme Court says that infringement is still present under such circumstances, shows that it regards the invention as still the same regardless of the substitution of the mechanical equivalent. The substitution of a mechanical equivalent thus does not change a combination into a different invention, and it therefore cannot be said that the reissue claims are not for the same invention unless they include levers. If plungers are mechanical equivalents of levers, the invention is still the same.

Parts That Give Motion to Other Parts May Properly
Be Claimed in Terms Broad Enough to Include
Other Means for Performing the Same Functions.

Appellant's right to claim the operating member that moves the tappet in broad terms, derives from a long established doctrine which Walker on Patents, Deller's Edition, summarizes as follows:

"Where some of the parts of a combination operate therein to give motion to other parts, which do the final work on the combination, it is proper to specify the former by the use of such terms as 'means,' 'mechanism,' or 'devices' for giving that motion, except when these terms are applied to an element or part which constitutes the essence of the invention."

(Sec. 167, p. 795.)

The operating member in appellant's combination operates therein to give motion to the tappet, as this Honorable Court observed in its decision in the *Associated* case. Furthermore, it is the tappet and rocker that do the final work of the combination. It is consequently proper, according to this long established doctrine as explained in Walker, to specify the operating member by such terms as "a manually movable operating means," as in claim 9, or a "manually movable operating member," as in claims 10 and 11.

The foregoing quotation from Walker says that these terms are proper "except when these terms are applied to an element or part which constitutes the essence of the invention." The essence of the instant invention of course lies in the tappet and rocker and the structure having to do with the coaxial relationship of these members when they are completely engaged. Certainly the essence

of appellant's invention is not in the lever shown in his patent as a means for moving the tappet. Both levers and plungers had long been used to operate automatic tuners and even to move tappets. It is consequently proper to refer to the part that moves the tappet, as a "manually movable operating means" or "manually movable operating member."

What is the reason behind the doctrine, expounded in Walker, that broad terms like these may be used for parts of a combination that "operate therein to give motion to other parts, which do the final work of the combination"? The clear reason is that it is immaterial what specific means is used to give motion to these other parts. The decision in *Imhaeuser v. Burke*, 101 U. S. 647, 656, which the Supreme Court reaffirmed in its recent opinion in the *Graver* case, had this to say about elements of a combination that have equivalents in the prior art:

"* * * the patent in respect to each of the respective ingredients comprising the invention covers every other ingredient which, in the same arrangement of the parts, will perform the same function, if it was well known as a proper substitute for the one described in the specification at the date of the patent."

This all applies to reissue patents as well as originals, for the statute, as previously quoted, says: "Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form."

XII.

The Second Tappet Shown in the Patent Is Used Only When a Second Tuning Shaft Is to Be Positioned, and It Is Not an Element of Any of the Claims Here at Issue.

There is a statement in this Honorable Court's opinion in the *Associated* case, which, though the opinion did not say so, may have had a bearing upon the ultimate holding that the plunger of the accused tuner was not the equivalent of the lever shown in the patent. This statement reads as follows:

“* * * The plungers perform a part, and only a part, of the function performed by appellant's levers F and 66.¹⁷ The part so performed is not performed in the same way, or in substantially the same way.”

Footnote 17 says: “Appellant's levers have a double function—that of operating the tappet 61 and that of operating the tappet 62. The latter function is not performed at all in the accused device.”

The Court did not say that it attached any significance to this observation about a double function, the ultimate statement being: “The part so performed is not performed in the same way, or in substantially the same way.” The holding of non-equivalence thus appears to refer solely to how the single function is performed; and the observation in the opinion to the effect that the lever shown in the patent moves two tappets, does not appear to have had anything to do with the holding of non-equivalence. Of course, the absence of a second tappet in the accused device was irrelevant to this matter, because one of the objects, as

set forth in the second paragraph of the patent, is "to make it possible for a single manual operation to tune either a radio set or a television set, or both;" and the claims at issue are *all* directed to a device for tuning only one set, and they therefore include only a single tappet. But the Court may nevertheless have attached an unexpressed significance to its observation, and since appellee tries throughout its brief to make it appear that the patent is directed solely to apparatus for simultaneously positioning *two* shafts, it may be hazardous for appellant merely to assume that this Honorable Court is fully aware of the facts and the pertinent law. The matter will therefore be considered.

It has already been mentioned that one of the stated objects of the invention is "to make it possible for a single manual operation to tune either a radio set or a television set, or both;" and that all the claims at issue are directed to a device for tuning one set only. Inasmuch as this Honorable Court is of course well aware that it is the claims we must deal with in determining whether there is infringement, the Court could have attached no significance to the absence of a second rocker and second tappet in the accused device unless it were somehow under the impression that all parts of the illustrated embodiment must be included in the claims, and that the claims must therefore include two rockers, two tappets, and an operating means for moving two tappets. Appellant does not believe that this Honorable Court could be under this impression, but inasmuch as appellee's brief seems to be encouraging such an interpretation of appellant's device and claims, the pertinent law will nevertheless be discussed.

It is in the claims, of course, that the patentee sets forth the various combinations of parts that he considers to embody his invention. As Judge Learned Hand said in *Claude Neon Lights, Inc. v. El Machlett & Son, et al.*, 36 F. 2d 574 at 575-576:

“* * * It is the claim which singles out from the complex disclosed those elements which constitute the ‘invention,’ and substantially the whole work of the Patent Office lies in determining, not whether the disclosure is new because all of it never is, but whether the claims proposed are. Strictly the disclosure should be used therefore only as the setting of the claims and to find what the words employed really mean.

* * * * *

“On the one hand, therefore, the claim is not to be taken at its face—however freely construed—but its elements may be treated as examples of a class which may be extended more or less broadly as the disclosure warrants, the prior art permits, and the originality of the discovery makes desirable. On the other, it is not to be ignored as a guide in ascertaining those elements of the disclosure which constitute the ‘invention,’ and without which there could be no patent at all.” (Emphasis added.)

Original claim 5 and all the claims added by the reissue except claim 12, call for only a single rocker and single tappet. Appellant thus claimed a tuner for operating a radio set only, which he had set forth as one of his objects in his original patent. The propriety of such claims is evident from the following paragraph from Walker on Patents, Deller’s Edition, Volume 2, Section 266, page 1232:

“A claim may cover the entire process, machine, manufacture, or composition of matter, which is set

forth in the description, or it may cover such parts, or such sub-processes, or such combinations, as are new and useful inventions; and the specification may contain a claim for the whole, and other claims for separate parts, and still other claims for separate sub-processes or combinations. [Citing decisions.] And the subject of a claim needs not to be operative alone. [Decisions.]”

In spite of the clear law on this point, an opponent trying to beg the question might argue that while appellant may have intended that his device could be used for tuning either a radio set or a television set alone, he did not contemplate that the unnecessary parts would be omitted in a tuner intended for the single purpose. That the superfluous parts *were* to be omitted in a single purpose tuner, is thoroughly established by the claims themselves; but if anyone should desire still additional proof, it may be found in the parent application [Defendant's Exhibit "O"] from which the original application was carved.

The parent application described several different tuners devised by appellant, each one of which could be constructed for tuning a single set, or for tuning two different sets simultaneously. In order to simplify the explanation of the first tuner discussed, it is first described in the form used for a single tuning operation. The very first figure, Fig. 1 [R. 883], shows a positionable member A mounted on the control shaft S, and the description [R. 851] says: “If the shaft S is attached to the shaft that controls the tuning apparatus of a radio receiving set, the movement of arm A to a definite position by means of pressing lever L will be the equivalent of turning a cali-

brated dial to a definite setting as is the usual procedure when tuning in a desired broadcasting station.”⁸

Fig. 3 [R. 884] shows the addition of extra parts so that a double tuning operation may be performed, and the specification [R. 852] says: “In Fig. 3, parts bearing the same reference letters are identical to those in Fig. 1. In this figure, however, an additional positioning arm C is introduced, which can be used to tune in a television station while arm A tunes in the accompanying broadcasting station.”⁹

After describing a complete tuner for two tuning operations, the specification says [R. 858]: “In using this automatic tuner for either a radio set or a television set *alone*, half the positioning arms and the yoke with its hubs are eliminated.”¹⁰ (Emphasis added.)

After describing still another tuner that may be used for two tuning operations, the specification again mentions that the parts for the second purpose may be omitted when only a single set is to be tuned, thus [R. 862]: “* * * However, if the automatic tuner is being used for either a radio set or a television set *alone*, therefore requiring only one positioning arm per station, a lug of the type previously described carried by the *single* arm makes it unneces-

⁸The first patent granted on the parent application was patent No. 2,084,851 [R. 982], which issued on June 22, 1937—three days after the divisional application was filed. The wording quoted above from the parent application appears in issued patent No. 2,084,851 at page 986 of the present record, column 1, lines 31-37.

⁹This wording appears in patent No. 2,084,851 at page 986, column 1, lines 50-55.

¹⁰This wording appears in patent No. 2,084,851 at page 987, column 2, lines 18-20. This 1937 patent was a part of the prior art when original patent No. 2,108,538 was granted.

sary to have any sort of projection on either lever. * * *”
(Emphasis added.)

The next tuner described is the one that was made the subject of the divisional application that issued as patent No. 2,108,538—the original of the reissue involved in the present suit. The portion of the specification in this parent file wrapper that was carved out for the specification of the divisional application, begins at the top of page 863 of the record and terminates on page 865. Immediately following the description of the tuner now covered by the reissue patent, the specification says [R. 865]: “As mentioned previously, automatic tuners of *any* of the types described *may be constructed for tuning either a radio set or a television set alone.*” (Emphasis added.) If they are “*constructed*” for one of these purposes *alone*, this clearly means that the parts for the other purpose are omitted, as previously mentioned in the description of the earlier described tuners.

There is thus no room whatever for any misconstruction to be placed upon the statement in the original and reissue patents (second paragraph of each document) that one of the objects is “to make it possible for a single manual operation to tune either a radio set or a television set, or both;”. When constructed as a single purpose tuner, the parts that would be used for an additional tuning operation are of course left out.

Original claim 5 included only a single rocker and tappet, as do reissue claims 7 and 8. Reissue claims 9, 10 and 11 also omit the extra rocker and tappet that would be required for television, but these three claims have added a manual operating means for moving the single tappet.

A patentee's right to claim such parts of his machine as are new and useful inventions, was shown in the quotation from Walker on Patents, Section 266, *supra*. This right was settled by the Supreme Court long ago in *Railroad Company v. Dubois*, 12 Wall. (79 U. S.) 47, 60, 20 L. Ed. 265, 268, where the Court said:

“Undoubtedly a patentee may claim and obtain a patent for an entire combination, or process, and also for such parts of the combination or process as are new and useful, or he may claim and obtain a patent for both.”

(a) Even if the Original Patent Had Contained No Claim Drawn to a Single Tappet and Rocker, the Law Is to the Effect That Such Claims Would Be Proper in the Reissue.

Even if the patentee had not specifically mentioned in the objects of his original patent that he intended to provide a tuner for a radio set alone, and even if he had not included a claim in the original drawn to a single tappet and rocker, he would nevertheless have the right to a reissue patent covering the portion of the device that is independently useful for a single tuning operation; in fact, even if there had been an entire *absence* of claims of this sort in the original patent, such absence would alone be sufficient to justify a reissue. Walker on Patents, Deller's Edition, Section 322, page 1366, says:

“Claims are the only operative parts of specifications. If an inventor has produced two or more inventions so allied that they may properly be secured to him in one letters patent, and if he fully describes all of those inventions in the descriptive part of his

specification, but covers only one of them by his claims, then his patent is operative as to one of those inventions, and inoperative as to the others. Inoperativeness of that kind is sufficient to lay the foundation of a right to a reissue. * * *

Appellant has shown in several different independent ways that the device of his reissue patent is not intended only for a double tuning operation, as appellee's brief infers, and that the claims which include only a single rocker and tappet are perfectly proper. The absence of a second tappet in plaintiff's tuners is thus entirely irrelevant to the issue of infringement, nor can the operating member of the accused tuners be distinguished from the operating member shown in the patent on the ground that the latter moves two tappets. When the appellant's combination is constructed for tuning a radio set, the operating member moves only a *single* tappet.

It has also been amply demonstrated in many different ways that appellant is entitled to claims in which the operating member is described in sufficiently broad terms to cover a lever, a plunger, or any other device that will serve the purpose of moving the tappet.

Moreover, the well established doctrine of equivalents applies to reissue patents as well as to original patents, and the statute specifically states that reissue patent claims have exactly the same effect in law as they would have had if filed in the final form in an original patent. Appellee thus cannot avoid infringement by omitting the lever shown in the patent and substituting another member already well known in the art as a proper substitute for a lever in the operation of automatic tuners as well as for the specific purpose of moving tappets.

XIII.

Appellee's Brief Contends That Appellee Should Be Given the Right to Use Appellant's Contribution in Order That "Uniformity of Justice" Might Prevail; but Inadvertent Admissions by Those Opposing the Patent in This and Previous Cases, Reveal Their Private Opinions That Justice Is on Appellant's Side.

The concluding sentence in appellee's brief reads: "Uniformity of justice requires that in the event it becomes necessary to decide the question of infringement in this case this Court hold that the aforesaid plunger type tuners, including those of appellee, do not infringe the patent in suit." But the thing that appellee seeks and misnames *uniformity of justice*, is a ruling from this Honorable Court that plaintiff may appropriate appellant's coaxial tappet-and-rocker combination by omitting the operating lever from the illustrative embodiment shown in the patent and substituting another kind of operating member already well known in the art—a type of expedient specifically prohibited by the Supreme Court. To justify such piracy, appellee has been unable to show that it makes any difference whatever whether the tappet is moved by a lever or by a plunger, contending only (Appellee's Br. p. 57) that "the traveling in an arcuate path by levers and in a straight path by plungers, is itself determinative of the issue of equivalency." But this Honorable Court in the *Six Wheel* case, *supra*, has already held that this difference between members of a combination does not avoid infringement (see pp. 59 and 60 hereof). Moreover, counsel for appellee contend that the General Motors rack tuner is the Zenith rack tuner operated by plungers instead of levers (Appellee's Br. pp. 33 and 57), and they thus inadvertently reveal

that they privately recognize no valid distinction between a plunger-operated tuner and a lever-operated tuner.

The patent attorneys and their experts who have opposed this patent in all the cases in which it has been involved, have likewise recognized that the use of a plunger for operating appellant's combination involves a mere substitution according to the preference of the manufacturer. Engineer Kilgour of the Crosley Corporation testified [R. 486] that Mr. Crosley himself stated before any experimental work had begun at the Crosley plant that he wanted a tuner that would be operated by a push button; and engineer Schwarz of General Motors refers to the G. M. *plunger*-operated rack tuner [Plaintiff's Exhibit 3] as only a *modification* of the *lever*-operated Schaefer rack tuner [R. 388].

The concluding paragraph in appellee's brief says: "Since the decision in the *Associated Case* by this Court in 1943, manufacturers of plunger-type tuners have relied on that decision and have produced and sold plunger type tuners accordingly." This is not true. At the subsequent trial of *The Richards and Conover* case, involving tuners made by Radio Condenser Company, the attorney and expert opposing the patent did not even assert that infringement had been avoided by using a plunger, but openly admitted that this was a simple substitution. The record in that case was filed by appellee herein with Plaintiff's Supplemental Brief, and it was made a part of the record on appeal by stipulation of both parties hereto [R. 684]. In answer to a question of attorney Mueller who was opposing the patent, Dr. Spotts, the expert for The Richards and Conover Company, testified as follows:

"A. If one wished to use a plunger that would give straight line motion as support for the tappet rather

than the pivoted lever which gives motion in the arc of a circle of a rather large radius, draftsmen would have no compunctions about substituting a plunger giving a straight line for the lever, giving an arc of a circle, since the motion is rather small while the tappet is being brought into contact with the rocker. A draftsman would make that substitution in the usual line of his work.

Q. (By the Court): Easy to do. A. Oh, yes.

Q. It would impose no serious problem where a lever is used and you decided you wanted to use a plunger, to change the design to make it work with a plunger? A. A draftsman does those things every day in the week in his usual line of work." (Page 182 of the printed record in *Leishman v. The Richards and Conover Company*.)

The attorneys who were responsible for bringing the declaratory judgment action against the present appellant in *Leishman v. Radio Condenser Company and General Instrument Corporation*,¹¹ likewise knew that it is immaterial by what means the tappet is moved; in fact, plaintiff's very first exhibit herein [R. 695] is a letter from Attorney Maxwell James, whose name appeared on the

¹¹The affidavit of Maxwell James, page 66 of the Record in *Leishman v. Radio Condenser Company and General Instrument Corporation*, says: "I am and have been for many years the attorney in patent causes for both of the plaintiffs in this suit." Another attorney who shared the responsibility of bringing that action was A. D. T. Libbey, as will hereinafter appear.

“Brief for Plaintiffs-Appellees” before this Honorable Court, No. 11652, and Mr. James says [R. 695] that the counterweight 39 which Marschalk uses to move his tappet *up* is the equivalent of the spring which appellee uses to raise his tappet. If these very different things are equivalents for moving the tappet *up*, certainly Mr. James recognized that plungers and levers are equivalents for moving the tappet *down*.

Another patent attorney having an official connection with Radio Condenser Company and General Instrument Corporation, specifically contended before the Patent Office that levers and plungers are equivalents for moving tappets in automatic tuners. The decision in the government’s suit against these concerns, 87 Fed. Supp. 157, shows at page 170 that Mr. A. D. T. Libbey was Assistant Secretary of Condenser Development Corporation, a wholly-owned *alter ego* concern which Radio Condenser and General Instrument created and empowered by contract¹² to handle their

¹²The decision shows at page 181 that Condenser Development Corporation was the Second Contracting Party, and on page 182 the decision quotes the following from the 1939 agreement:

“‘As supplemental to clauses 4 and 8 of said agreement of August 7th, 1934, each of the first contracting parties agrees to notify in writing each of the other first contracting parties and the second contracting party of any charge made by others, as soon as such charge is made, of alleged infringement of any Letters Patent in the field of *radio tuning devices* or variable condensers . . . and in the event that the same be decided to be the common concern of the parties hereto, it is agreed that the second contracting party shall thereupon undertake to investigate the infringement charge and to take any affirmative action thereon that the second contracting party may deem advisable to take . . .’”

patent litigation. In a Patent Office interference in which Radio Condenser Company, General Instrument Corporation and Condenser Development Corporation were interested, Mr. Libbey filed a paper in the Patent Office contending that the substitution of a plunger for the lever in the tuners of Marschalk or Leishman would be but the substitution of a mechanical equivalent well known in the art. In view of appellee's statements alleging reliance by these manufacturers upon this Honorable Court's decision in the *Associated* case, it is believed that this Court should take judicial notice of the signed statement of Mr. Libbey, so that the Court will know the private opinion of Mr. Libbey as well as that of Mr. James which is already before the Court. A photostatic copy is being filed herewith as Defendant's Exhibit CCCC, and the application of Mr. Libbey's language to the Marschalk and Leishman tuners is shown in the appendix hereto on pages 10 to 12.

Mr. James and Mr. Libbey and the litigants Radio Condenser Company and General Instrument Corporation whom they represented, thus imposed upon this Honorable Court by representing a state of facts exactly opposite from what they knew these facts to be.

The last paragraph of appellee's brief recommends uniformity of justice. The only uniformity that will work justice in this case is for this Honorable Court to render an opinion that will be in conformity with the private opinions of the attorneys and litigants who used this Court in the *Radio Condenser* case to further their adjudged illegal

schemes.¹³ Such a decision by this Court will also conform with the opinions of appellee's counsel and of General Motors engineer Schwarz who show that they recognize no distinction between moving a tappet by a lever and moving a tappet by a plunger when they refer to the General Motors tappet and rack tuner [Plaintiff's Exhibit 3] as a modification of the Schaefer tuner or call it the Schaefer tuner operated by plungers instead of levers.

If this Honorable Court's opinion as to *validity* as well as infringement is to conform with the one that must prevail at the Zenith Corporation and at the Crosley Corporation and at General Motors Corporation, this Honorable Court must hold that appellant's simple combination involved invention. For the Zenith engineers were unable to think of a better solution to the problems of adjustable

¹³The court in *United States v. General Instrument Corporation et al.*, held the contract under which Radio Condenser Company and General Instrument Corporation acted in suing Leishman to be illegal; and the Condenser Development Corporation, which decided upon the course to pursue against Leishman [Gov. Ex. 53], was held to have been formed in violation of the Sherman Act.

Leishman has filed a timely motion under Rule 60(b) to reopen the Ninth Circuit case of *Radio Condenser Company and General Instrument Corporation v. Leishman* on the grounds of newly discovered evidence. This newly discovered evidence showed (1) that these corporations brought the action with unclean hands and were therefore not entitled to a judgment against Leishman; (2) that as to the equivalency of plungers and levers for operating Leishman's combination, the corporations are bound by the statements of James and Libbey; and (3) that appellant's patent actually showed a plunger, the projection 57 on the operating lever being a plunger according to texts discovered since the trial of that case. This motion has not yet been set for hearing.

tappet tuners than to interpose ten movable parts between the tappet and the rotatable member, and after trying other tuners they have finally settled on appellant's coaxial tappet and rocker structure because "This system is so simple and fool proof." And the Crosley engineers worked for nearly a year to provide a satisfactory tuner and were unsuccessful until after Chief Engineer Johnston requested an investigation of appellant's patent No. 2,084,851, the file wrapper of which disclosed the coaxial tappet and rocker construction. And the General Motors engineers, with the Zenith-Schaefer tuner before them, could provide nothing better than their Exhibit 3 tuner with ten extra parts in a five button set. After abandoning that tuner and making more than a million radio receivers embodying appellant's far simpler structure, they want this Honorable Court to give them a clean bill of health.

The appropriation of appellant's invention by these large corporations has gone far enough, and it is the clear duty of this Honorable Court to render a decision in favor of appellant on all issues.

Respectfully submitted,

LEROY J. LEISHMAN,

In Propria Persona.

JOHN FLAM,
Counsel.

APPENDIX.

I.

Re: Testimony From Oklahoma Trial.

The expert witness opposing the patent in The Richards and Conover case was Dr. Spotts, Associate Professor of Machine Design at Northwestern University. He originally advanced the same argument that appellee has appropriated here—that is, that the position of the pivot 55 of Schaefer's tappet bore a coaxial relationship to the rectilinearly movable members 32 and 34 in Schaefer's device. But the proposition that members moving in a straight line can have an axis and that the position of the axis of the tappet 55 has anything to do with the prevention of creeping in Schaefer's mechanism, sounded rather preposterous to the Court; and the Court accordingly questioned Dr. Spotts in order to learn the real truth of the matter. The Court's examination of Dr. Spotts on this subject appears on page 192 of the Oklahoma record and is as follows:

“Q. (By the Court): Can you take that round spot, No. 55 [the pivot of Schaefer's tappet], in that yellow design, and put it any place other than where it is and the thing still work properly? A. *You can move it sidewise.*

Q. Draw pictures of it where it could be. Can you do that? Just take your pencil and draw a lot more of them, a lot of other positions where it could be. A. It could be located, if you have lateral support for members 26 and 27; *then you move this center sidewise without any effect in the operation.*

Q. It could be anywhere on that line? A. *It could be sidewise providing parts did not interfere. Providing that did nothing more than make points 57 and 58 retain contact with the horizontal surface.*

Q. It could be anywhere on that line you have drawn across there? A. I don't mean over here (indicating).

Q. I understand, but a reasonable distance so it would not conflict with any of the other parts. *Now if it is moved a quarter of an inch to the left of your line you say it would still work?* A. Providing there is lateral guidance.

Q. It will still work. *Now if you moved it there would it be coaxial? That is what I want to know.* Just draw one on there and tell me whether it is coaxial or not. *Is that coaxial? You can answer that yes or no.* A. *There is no axis for the body that has up and down motion.*

Q. *Then your answer is yes or no?* A. *The answer is no.*" (Emphasis added.)

Dr. Spotts thus testified that the pivot 55 of Schaefer's tappet could be located in a wide variety of positions "without any effect in the operation" of his device. Furthermore, Dr. Spotts testified that "there is no axis for a body that has up and down motion," as do the members that are engaged by the tappet in Schaefer's device; and he said that there is no coaxiality in the Schaefer mechanism.

II.

Re: Defendant's Exhibit AAAA Mentioned in
Footnote 1 of the Foregoing Brief.

Footnote 12 appearing on page 75 hereof shows by excerpts from the opinion in the government's case against Radio Condenser Company and General Instrument Corporation that these concerns empowered Condenser Development Corporation to take affirmative action against anyone alleging "infringement of any letters patent in the field of radio tuning devices." It is this concern that is referred to by the initials C.D.C. in the following extract from Defendant's Exhibit AAAA, which is a certified copy of a letter from Mr. James that constituted one of the exhibits in the government's case against Radio Condenser Company and General Instrument Corporation:

"As supplemental to this last mentioned subject we discussed the arrangements between the members of C.D.C. in the event of threatened litigation based on the possible infringement of patents owned by others, and we showed at some length that through C.D.C., and at C.D.C.'s cost, the members of C.D.C. were kept on the alert as to new patents owned by others and cooperated to build up defenses against such patents if they deemed such patents as not valid, and cooperated to consider the purchase of such patents or being licensed thereunder if they deemed such other patents valuable. *We even explained that in the recent California suit brought by Leishman we even offered to lend assistance, and that we did give some assistance to the defending attorneys against his patent.* We ended this argument by saying that if Winters & Crampton were threatened with any suit, they could come to C.D.C. for the information and assistance that C.D.C. would in such case be gathering and building up pursuant to these provisions in their agree-

ment. They seemed quite satisfied with this thought and Mr. Swanson wondered whether a clause could not be incorporated in the agreement to take care of this. We and some of the others indicated that that would not be necessary since if we were ready to help strangers as we were, we would certainly lend assistance to our own licensee and give them the benefit of any such study or action as we may have made in the matter." (Emphasis added.)

This letter, as will be observed from the exhibit itself, was written on October 25, 1944. The only suit which Leishman prosecuted in California prior to that time was the one against Associated Wholesale Electric Company and it is therefore this suit to which Mr. James makes reference. This letter thus shows that Condenser Development Corporation, acting for Radio Condenser Company and General Instrument Corporation, assisted the defending attorneys in that action.

III.

Re: Reference in Footnote 6 Appearing on Page 48 of the Foregoing Brief.

In footnote 6 on page 48 of the foregoing rebuttal memorandum the statement was made that there was no conflict in Leishman's testimony in this case and in the *Associated* case pertaining to his reasons for obtaining a reissue, and that the question to which he answered "no" was not the same question to which he answered "yes" in the *Associated* case. The question to which he answered "yes" in the *Associated* case was read into the present record on page 302 and was as follows:

"Q. Isn't it a fact, aside from any intention you had of narrowing the new claims that you added by the reissue application, that one of the purposes of

the reissue, one of your purposes, was to so modify the language of this discussion with the Crosley representatives about it of Claim 5 that you could eliminate that question of non-infringement?"

Mr. Leishman replied: "I think I can say yes to that question."

It will be noted that Mr. Lyon in this question asked Mr. Leishman whether his purpose was to modify the language of the discussion with the Crosley representatives about Claim 5. One of the objects of the reissue was to obtain claims that would not permit the deliberate and strained misconstruction that the Crosley representatives had placed upon Claim 5 during the said discussion. The Crosley representatives at that time maintained that the words referring to the tappet in Claim 5 referred to the lever. In the claims that were added by the reissue the terms were modified and qualified so that no such misconstruction could be made to seem plausible by even the most accomplished sophist.

The reissue oath [R. 761] states in the final paragraph on page 763 that he did not become aware of the defects in his original patent "until he undertook to license manufacturers under the patent." This refers to the conference with the Crosley attorneys. The facts regarding the reissue are all open and above-board, and appellee's efforts to make it appear that there was something irregular about the reissue are totally unjustified. Nothing whatever has been claimed in the reissue that appellant would not have been entitled to claim in the original patent. The

coaxial relationship between the tappet and the rocker which appellee claims was an afterthought brought into being by the Crosley device, was disclosed both in the drawings and wording of the original patent; in fact, the drawings showing this relationship were incorporated in the 1934 parent application from which the original of the present reissue patent was carved.

IV.

Re: Footnote 7 Appearing on Page 57 of the Foregoing Brief.

Appellant's Exhibit BBBB, which is a certified copy of the allowed Canadian application on the tuner here involved shows that Claims 7 to 11 thereof are identical to the claims bearing the same numbers in the reissue patent here involved and read as follows:

“7. In combination with the tuning mechanism of a radio apparatus, of a rotatable rocker mounted upon a shaft operatively connected with said mechanism, said rocker having two arms each extending on a different side of said shaft; means adjustably movable about a pivot and acting upon bodily movement in one direction to slidably engage either arm of said rocker and push it in one direction to an angular position at which the movement of said rocker is arrested by the collision of said means and the oppositely moving other arm of said rocker; and a spring for holding said means in a normally inoperative position; said rocker constructed so as to admit at least a portion of said means between said arms.

“8. The combination with the tuning mechanism of a radio apparatus, of a rotatable rocker mounted upon a shaft operatively connected with said mechanism, said rocker having two arms each extending on a different side

of said shaft; means adjustably movable about a pivot and acting upon bodily movement in one direction to slidably engage either arm of said rocker and push it in one direction to an angular position at which the movement of said rocker is arrested by the collision of said means and the oppositely moving other arm of said rocker; and a spring for holding said means in a normally inoperative position; the axis of said means being substantially co-axial with the axis of said rocker when said means is in engagement with both of said arms.

“9. In a mechanism for angularly positioning a control of a radio device, a combination including: a rotatable rocker comprising two shoulders lying on opposite sides of the axis of said rocker; and a manually movable operating means comprising an adjustably mounted positioning element adapted upon movement of said means in one direction to engage one shoulder of said rocker and rotate said rocker to a position at which the movement of said element is arrested by the collision of said element and the oppositely moving other shoulder of said rocker; said rocker constructed to permit at least a portion of said means to pass beyond a line connecting the points on said shoulders at which the shoulders are contacted by said means.

“10. In a mechanism for angularly positioning a control of a radio device, a combination including: a rotatable rocker comprising two shoulders lying on opposite sides of the axis of said rocker; a manually movable operating member; and a positioning element adjustably mounted on a pivot carried by said member; said element adapted upon movement of said member in one direction to engage one shoulder of said rocker and rotate said rocker to a position at which the movement of said rocker is arrested by the collision of said element and the oppositely moving

other shoulder of said rocker; the axis of said element and the axis of said rocker being substantially co-axial when said element is in engagement with both of said shoulders.

"11. In a mechanism for angularly positioning a control of a radio device, a combination including: a rotatable rocker comprising two arms lying on opposite sides of the axis of said rocker; a manually movable operating member; a positioning element adjustably mounted on a pivot carried by said member; said element adapted upon movement of said member in one direction to engage one arm of said rocker and rotate said rocker to a position at which the movement of said rocker is arrested by the collision of said element and the oppositely moving other arm of said rocker; said rocker having a recess between said arms so that the axis of said element and the axis of said rocker may be substantially coaxial when said element is in engagement with both of said arms; and means operable from the external end of said member for holding said element in adjusted position."

The allowed Canadian application, like the original United States Patent No. 2,108,538, was a division of an earlier application showing several other tuners, but the Canadian divisional application was not filed until December 21, 1945, as shown on the first page of the specification as well as on the cover bearing the certification of the Canadian Patent Office. The divisional application was thus filed after this Honorable Court rendered its decision in the *Associated* case.

Appellant herein desired to verify by the Canadian Patent Office that the claims here at issue are for the same invention as for the original patent and he therefore included the present reissue claims in that original application. He desired further to show that the identical disclosure, con-

sisting of the same drawings and the same specifications, are alone sufficient to justify claims in which the manual operating member could be described in terms broad enough to include plungers. It was of course not necessary for him to show plungers in the specification to justify such claims because plungers were well known in the art. He therefore used the identical drawings of his original and reissue United States patents as the drawings for his Canadian application, and the entire description of the apparatus is identical to the specifications in these United States patents. So that it would be perfectly clear that the reference to the operating member in terms sufficiently broad to include plungers was not an inadvertence on the part of the Canadian Patent Office, a statement was incorporated in the next to the last paragraph of the specification, as mentioned in footnote 7 on page 57 of the foregoing brief, to show that Leishman intended the claims to be interpreted as covering any kind of an operating means, and a plunger was specifically mentioned. Appellant thus sought to demonstrate that a disclosure, including drawings identical to those here involved, was alone sufficient to justify claims intended to be construed as referring to any kind of an operating means whatsoever—whether lever, plunger, or some other device for transmitting motion to the tappet. The allowance of these Canadian claims under these circumstances is another proof, in addition to those mentioned in the foregoing brief, that such claims are not only for the same invention as the original patent but that they are entitled to be interpreted precisely as appellant has stated.

The Canadian Patent Office is thus in agreement with the United States Patent Office, the United States District Court for the Western District of Oklahoma, the Court of

Appeals for the Tenth Circuit, as well as Judge Harrison in the *Associated* case. They all realized that Leishman's invention had nothing to do with the operating means. While not ruling formally on the issue of infringement, Judge Harrison's opinion contained these statements (36 Fed. Supp. 804, 806): "It cannot be seriously denied that the accused device uses a rotatable rocker, adjustable tappet and when brought to rest the two parts are coaxial —the essential elements contained in the plaintiff's [Leishman's] structure." And three paragraphs later he further stressed this point, saying ". . . as I have stated before, it [the accused device] contained plaintiff's structure."

In view of all the new evidence on this point that was not before this Honorable Court in the *Associated Radio Condenser* cases, it is believed that this Honorable Court will now share the same opinion.

V.

Re: Defendant's Exhibit CCCC and the Statement of Mr. Libby Regarding the Equivalence of Plumbers and Levers.

It was not known by appellant until the decision was rendered in the *United States v. General Instrument Corporation, Radio Condenser Company, et al.*, that Mr. A. D. T. Libby had an official connection with the *alter ego* concern which both of these companies own and authorized to handle their patent matters. The decision in that case shows Mr. Libby's official connection as mentioned in the foregoing rebuttal brief in the sentence just preceding footnote 12. Mr. Libby's "Statement under Rule 114" was filed with the United States Patent Office in an interference in which he sought to prevent the allowance of a

claim because it was unpatentable.¹ Mr. Libby explained that the reason it was unpatentable was that it read squarely upon the Marschalk device excepting that it called for a plunger instead of a lever. He showed on page 2 of his statement [Deft. Ex. CCCC] wherein each of the elements set forth in the claim were present in the Marschalk structure and that the only deviation called for was the substitution of a plunger for the lever shown in Marschalk. On page 3 he states:

“It has been common practice in the past to use a lever-type adjustment as in Marschalk, as well as the plunger-type adjustment as called for by the claim [the claim to which he was objecting in his statement].

“One of the very earliest patents on plunger adjustment is Marvin. Other plunger-type adjustments are illustrated by the patents of Bast and the British Freytag.”

The Marvin and Bast patents were cited in the foregoing brief as old examples of the use of plungers in this art.

On page 2 of Mr. Libby's statement he lists several prior art patents, including the patent here at issue, namely, the Leishman reissue Patent Re. 20,827.

On the last page of Mr. Libby's statement he argues to the effect that the substitution of the plunger for the

¹Mr. Libby's name was misspelled "Libbey" in the decision, but the initials were given in each case as "A. D. T." and it is obvious that the person referred to in the decision is the one who wrote the "Statement under Rule 114" and who spells his own name "Libby." This is also established by Plaintiff's Exhibit 4 in the instant case [R. 702]. This exhibit is a patent assigned to Condenser Development Corporation, the concern of which "Mr. Libbey" was Assistant Secretary" [R. 707], and the signature at the bottom of pages 702, 703, 704, 705 and 706 verifies that he spells his name "Libby."

lever shown in the patent here at issue would be but the substitution of a mechanical equivalent. He said:

“As to the application of the Leishman patent, this is well expressed in Leishman’s argument in the DeJong application involved in this Interference (Leishman having purchased the DeJong application and taken over in person the prosecution thereof) in the following words:

“‘Claim 13 is differentiated from Leishman by only two words “plunger” and “longitudinally,” neither of which describe a patentable difference. If “longitudinally,” is omitted and “plunger” changed to *manual* it will read directly upon Leishman.’

“(See also Leishman’s argument in the DeJong file with respect to Vaselli patent 1,846,289.) A glance at the drawing will make the application obvious without further argument.”

Mr. Libby’s final statement that “a glance at the drawing [of the Leishman reissue patent] will make the application [of his argument regarding the equivalence of the plunger for the lever shown in this patent] obvious without further argument,” shows conclusively that Mr. Libby was well aware that the equivalence of plungers for levers in the operation of the tappet shown in the reissue patent is not a debatable matter.

It was stated in the foregoing brief that Mr. Libby’s colleague, Mr. James, specifically stated in a letter [Pltf. Ex. 1] that weights and springs are equivalents for moving the tappet up and that Mr. James was therefore obviously of the opinion that it was immaterial by what means the tappet is moved. We now have Mr. Libby stating specifically that a plunger and a lever are equivalents for this purpose.